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<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)</b>	<b>Docket Number (Optional)</b> 336549US
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First named inventor: TAKASHI SHIRAKAWA, et al.

Application No.: 09/139,307 Art Unit: 2861

Filed: August 24, 1998 Examiner: Tran, H.

Title: THERMAL HEAD

Attention: Office of Petitions  
**Mail Stop Petition**  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450  
 FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus any extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional

1. Petition Fee

☐ Small entity-fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Application claims small entity status. See 37 CFR 1.27.

☒ Other than small entity-fee \$ 2,730.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Replacement Drawings (identify type of reply):

☒ has been filed previously on February 10, 2009  
☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ \$1,510.00

☒ has been paid previously on February 10, 2009  
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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## 3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

*Andrew M. Ollis*

Signature

*October 8, 2009*

Date

Andrew M. Ollis

Type or Printed name

1940 Duke Street

Address

Alexandria, Virginia 22314

Address

40,749

Registration Number, If applicable  
(703) 413-3000

Telephone Number

Enclosures:

- ☒ Fee Payment
- ☐ Reply
- ☐ Terminal Disclaimer Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☒ Other: Exhibits 1-25; Request for Extension of Time

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

- ☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

*10/8/2009*

Date

*Andrew M. Ollis*

Signature

Andrew M. Ollis

Typed or printed name of person signing certificate



## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



Docket No.: 336549US99SD



Attention: Office of Petitions  
**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

ATTORNEYS AT LAW

RE: Application Serial No.: 09/139,307  
Applicants: TAKASHI SHIRAKAWA, et al.  
Filing Date: August 24, 1998  
For: THERMAL HEAD  
Group Art Unit: 2861  
Examiner: Tran, H.

SIR:

Attached hereto for filing are the following papers:

**Renewed Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b); Exhibits 1-25; Request for Extension of Time**

Credit card payment is being made online (if electronically filed), or is attached hereto (if paper filed), in the amount of \$2,730.00 to cover any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, L.L.P.

Andrew M. Ollis

Registration No. 40,749

Customer Number  
**22850**

(703) 413-3000 (phone)  
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(OSMMN 07/09)



**UNITED STATES PATENT AND TRADEMARK OFFICE**

Petitioner(s): Alps Electric Co., Ltd.

Serial No.: 09/139,307

For: THERMAL HEAD

Filed: August 24, 1998

Examiner: Tran

Art Unit:

Confirmation No.:

Customer No.:

Attorney Docket No. 336549US

**Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**RENEWED PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)**

Dear Sir:

Petitioner Alps Electric Co., Ltd. ("Alps" or "Petitioner") submits this paper in response to the Decision on Petition ("Decision") mailed by the Commissioner for Patents on July 9, 2009. Petitioner respectfully requests revival of U.S. Application No. 09/139,307 ("the '307 Application") in light of the additional facts and evidence submitted below and in the attached declarations and exhibits.<sup>1</sup>

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<sup>1</sup> For the convenience of the Office, a listing of the Exhibits can be found in Appendix A at the end of this Renewed Petition.

## **SUMMARY**

Petitioner filed a Petition for Revival under 37 C.F.R. § 1.137(b) (“Original Petition”) on February 10, 2009 seeking revival of the ‘307 Application. The Commissioner dismissed the Original Petition on July 9, 2009, finding that it lacked a statement that the entire delay in filing the required reply, from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional. In particular, the Commissioner found that the Original Petition did not show, to the satisfaction of the Commissioner, that (1) the delay in reply that originally resulted in the abandonment of the ‘307 Application, and (2) the delay in filing the Original Petition pursuant to 37 C.F.R. § 1.137(b) to revive the application, were unintentional.

Petitioner submits this Renewed Petition pursuant to 37 C.F.R. § 1.137(b) with additional supporting materials. These materials further confirm that the ‘307 Application went abandoned solely because of the deceitful acts of the attorney assigned to prosecute the application, William Prendergast. Mr. Prendergast hid his actions and inactions from Petitioner and his firm Brinks Hofer Gilson & Lione (“Brinks Hofer”) and repeatedly and deliberately misled Petitioner and Brinks Hofer about the status of the ‘307 Application. When the abandonment was finally revealed to Petitioner, Petitioner diligently pursued revival of the application.

Summarizing briefly, the United States Patent and Trademark Office (“PTO”) sent Mr. Prendergast a Notice of Allowance on June 3, 1999. Ex. 3. The due date for paying the fee was set for September 3, 1999. The associated PTO papers stated that new formal drawings needed to be submitted before the patent could issue. On June 14, 1999 Mr. Prendergast mailed the notices and attachments to Alps and wrote “Unless I hear otherwise from you, I will pay the issue fee and file new formal drawings about one month before the due date.” Ex. 1. Alps did not instruct Mr. Prendergast to withhold payment of the issue fee or file corrected drawings.

Based on Mr. Prendergast's letter, Alps reasonably assumed that Mr. Prendergast would pay the issue fee and file new formal drawings as he said he would. Mr. Prendergast, however, never paid the issue fee or filed revised drawings. Instead, he misled the Brinks Hofer docketing department into believing that the payment had been made and the drawings filed.

A Notice of Abandonment was mailed to Mr. Prendergast on November 9, 1999 (Ex. 6) and Brinks Hofer docketed dates for a response. Mr. Prendergast never forwarded the Notice of Abandonment to Alps and did not file a response, yet he informed the Brinks Hofer docketing department that a response had been filed. Relying on its U.S. counsel, Petitioner had no knowledge that formal drawings had not been submitted, the issue fee had not been paid, and that a Notice of Abandonment had been issued. Instead, Petitioner waited to be informed by its U.S. counsel of further developments in the case. When Petitioner asked about the status of the file in 2006, Mr. Prendergast falsely advised Petitioner that the PTO had lost the file. In a final act of deception on June 20, 2008, Mr. Prendergast informed the Brinks Hofer docketing department that Petitioner wished to abandon the '307 Application and close the file, even though Alps never gave any such instruction.

At no time did Petitioner intend to abandon the '307 Application, delay in submitting formal drawings and paying the issue fee, or delay in filing a petition to revive the '307 Application. Because the unusual delay between the abandonment of the '307 Application in 1999 and the Petition to Revive in 2009 was directly attributable to the extraordinary acts of Mr. Prendergast, Petitioner respectfully submits that this Petition to Revive the unintentionally abandoned '307 Application should be granted.

## **FACTS**

### **A. William Prendergast Had Responsibility for Prosecuting the ‘307 Application**

The ‘307 Application was filed by Brinks Hofer on August 24, 1998. Gustavo Siller, a shareholder at Brinks Hofer, was ultimately in charge of all Alps patent applications from March 1998 to the present. Ex. 16, Declaration of Gustavo Siller, Jr. (“Siller Dec.”), ¶¶ 4, 11. However, Mr. Siller was not involved in day-to-day work on the ‘307 Application. *Id.*, ¶ 11. Instead, Mr. Siller’s partner Mr. Prendergast was responsible for the prosecution of the ‘307 Application. Mr. Prendergast’s responsibility is confirmed, for example, by the June 1999 letter forwarding the Notice of Allowance (Ex. 1), the November 1999 Notice of Abandonment addressed to him from the PTO (Ex. 6), 2007 and 2008 correspondence between Mr. Prendergast and Alps (Exs. 9, 10, 22, 23, 25), and a June 20, 2008 memo from Mr. Prendergast to the Brinks Hofer docketing department closing the ‘307 Application file (Ex. 11). Finally, Mr. Prendergast’s responsibility is confirmed by the fact that the ‘307 Application was found in his office during Brinks Hofer’s internal investigation of the matter in 2008. Siller Dec., ¶ 5.

### **B. Alps Had Authority and Control over Prosecution of the ‘307 Application**

At all times relevant to the abandonment of the ‘307 Application and the period of time between abandonment and the filing of the petition to revive the ‘307 Application, Alps was assignee of the ‘307 Application and, therefore, had authority to prosecute the application and control of the ‘307 Application’s prosecution. Ex. 17, Supplemental Fukasu Declaration (“Supp. Fukasu Dec.”), ¶¶ 2-3.

### **C. Brinks Hofer Docketed All Due Dates for the ‘307 Application**

From the time the ‘307 Application was filed in 1998 to the present, Brinks Hofer has had an electronic docketing system in place to docket all due dates for every prosecution matter



handled at the firm. Siller Dec., ¶ 9. During this time period, this docketing system was successfully used to prosecute thousands of applications. Id. When the '307 Application was filed by Brinks Hofer in 1998, the application was entered into the docketing system and all due dates were docketed into the system. Id., ¶¶ 2, 6, 17, 18, 20, 21; Ex. 14.

**D. Mr. Prendergast Failed to Submit Corrected Formal Drawings and Pay the Issue Fee and Misled the Brinks Hofer Docketing Department**

On June 3, 1999 the PTO mailed a Notice of Allowance, a Notice of Allowability and a Notice of Draftperson's Patent Drawing Review. Ex. 3. Dates of July 3, August 3 and September 3, 1999 for submission of the drawings and payment of the issue fee were docketed by the Brinks Hofer docketing department. Ex. 14. The electronic docket report shows a "completed" date of September 3, 1999 for these items. Ex. 14; Siller Dec., ¶¶ 17, 18. While no pink cards<sup>2</sup> were found for these cleared dates, copies of what purport to be a signed cover sheet for the submission of formal drawings and payment of the issue fee, along with a check in the amount of the issue fee, were found in the Brinks Hofer '307 Application file. Exs. 4, 5; Siller Dec., ¶ 19. However, these documents were never filed with the PTO. Siller Dec., ¶ 19. Based on his pattern of misrepresentations,<sup>3</sup> there is reason to suspect that Mr. Prendergast submitted copies of these documents to the Brinks Hofer docketing department to cause them to clear the related dates even though the documents were never filed with the PTO. Siller Dec., ¶¶ 16, 18-20. Whether these documents were intended to have been filed by Mr. Prendergast in 1999 or have some other origin can not be determined, as Mr. Prendergast has refused to speak to both Brinks Hofer and the undersigned counsel about the '307 Application. Siller Dec., ¶ 8; Exs. 19-21. Regardless, Petitioner believed Mr. Prendergast had filed the corrected drawings and paid

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<sup>2</sup> See discussion of pink cards below in the next section E.

<sup>3</sup> See, e.g., the renewed petitions to revive filed in applications nos. 08/960,481; 08/652,284; 08/738,435; 08/740,521; and Exs. 12, 13.

the issue fee. Ex. 15, Fukasu Declaration attached to initial petition (“Fukasu Dec.”), ¶ 7; Siller Dec., ¶ 16

**E. The Brinks Hofer Docketing System Would Have Regularly Reminded Mr. Prendergast of the Due Date for Responding to the June 3, 1999 Notice of Allowance**

According to the firm’s standard operating procedures, Brinks Hofer’s docketing department had a system to electronically docket reminders and due dates and provide written and voicemail reminders of due dates to the responsible attorney for each patent application. Siller Dec., ¶ 12. The dates for a response to the June 3, 1999 Notice of Allowance and Issue Fee Due were docketed by Brinks Hofer. Ex 14. In this case, the Brinks Hofer docketing department would have sent regular reminders to Mr. Prendergast about paying the issue fee and submitting the corrected formal drawings until it had been advised that a responsive action had been filed. Siller Dec., ¶ 12. Once a response had been filed, under normal procedures a “pink card” would have been sent to the Brinks Hofer docketing department indicating that a response had been filed and, typically, attaching a copy of the filed submission. Id., ¶ 13. However, if a response was filed after hours, an attorney could submit the card to the docketing department and bypass normal procedures. Id.

The Brinks Hofer docketing system was designed to keep responsible attorneys from missing any PTO deadlines. Id., ¶ 15. However, the Brinks Hofer docketing system was not designed to prevent outright fraud (particularly from shareholders in the firm), and was instead dependent on honest responses from the firm’s attorneys to function properly. Id. Unfortunately, when a rogue shareholder repeatedly misled the Brinks Hofer docketing personnel as in the present case, the safeguards inherent in the Brinks Hofer docketing system could be disabled. Id., ¶¶ 6, 13. Prior to Mr. Prendergast’s fraud being uncovered in 2008, Mr.

Siller had confidence in the Brinks Hofer docketing system and had no reason to question its reliability. Id., ¶ 15.

**F. Mr. Prendergast Was Informed of the Abandonment, Failed to Respond to the Notice of Abandonment, and Misled the Brinks Hofer Docketing Department**

On November 9, 1999 the PTO mailed a Notice of Abandonment to Mr. Prendergast. Ex. 6. The Notice of Abandonment was docketed by the Brinks Hofer docketing department. Ex. 14; Siller Dec. ¶, 21. Once again, as the responsible attorney, Mr. Prendergast would have received regular oral and written reminders concerning a petition to revive the abandoned application, or a reminder to otherwise act on the Notice of Abandonment. The Brinks Hofer docket sheet includes entries for response dates to the Notice of Abandonment between December 1999 and October 2000. Ex. 14. Some of these docket entries report a “Completed” date of January 10, 2000. Id. Petitioner has been unable to determine with certainty why the docket sheet reports a “completed” date of January 10, 2000. However, it is believed likely that Mr. Prendergast gave an instruction to the docketing department that the Notice of Abandonment had been responded to in January 2000 and that the date could be cleared. Siller Dec., ¶ 21. Obviously, Mr. Prendergast never actually responded to the Notice of Abandonment and appears to have deceived the Brinks Hofer docketing system once again.

**G. Mr. Prendergast Failed to Advise Petitioner of the ‘307 Abandonment**

As noted above, a Notice of Abandonment was mailed to Brinks Hofer on November 9, 1999. Ex. 6. Yet, Mr. Prendergast failed to inform Alps of the abandonment. Siller Dec., ¶¶ 6, 21. Thus, at the time the ‘307 Application became abandoned, and for many years afterwards, the Petitioner was unaware of the abandonment. Fukasu Dec., ¶ 9. Instead, Alps believed the formal drawings had been filed and the issue fee paid. Id., ¶ 7.

#### **H. Petitioner Relied on Brinks Hofer While it Awaited Action from the PTO**

During the period from 1999 to 2006, Petitioner believed that the '307 Application was pending and that the delay in prosecution was due to the PTO's inaction. Fukasu Dec., ¶¶ 8, 9. Petitioner also relied on Brinks Hofer as its U.S. counsel to notify it of any developments and deadlines and for all aspects of U.S. patent procedure. Supp. Fukasu Dec., ¶ 4. Petitioner had no independent mechanism other than its reliance on Brinks Hofer for recognizing unusually long periods of delay in prosecution of the '307 Application. *Id.* Ultimately, after a review of its U.S. cases in 2006, Petitioner determined that no PTO action had occurred for several years and Alps asked Brinks Hofer for an update on the status of the '307 Application in 2006. *Id.*, ¶ 5; Exs. 7, 8.

#### **I. Mr. Prendergast Deceived Petitioner After Inquiries into the '307 Application Status**

In 2006, Alps began an internal inquiry into the status of several applications, including the '307 Application, where no PTO action had occurred over several years. Ex. 7. As a result, on December 28, 2006, Petitioner sent an e-mail to Brinks Hofer inquiring about the status of the '307 Application, unaware that the '307 Application had gone abandoned. Ex. 8. Mr. Prendergast responded on January 11, 2007, stating he had contacted the PTO and that the PTO had advised him he could expect actions in the next 2-3 months and that the delay was due to the fact that the PTO had lost the file. Ex. 9. None of this was true, of course, since Mr. Prendergast had hidden the existence of the abandonment of the application from Petitioner.

After further inquiry from Petitioner on July 11, 2007, Mr. Prendergast, on July 14, 2007, e-mailed Alps stating that the '307 Application matter was being investigated and that he scheduled a call with a PTO supervisor to attempt to resolve the matter urgently. Exs. 10, 22. In response on July 17, 1999, Petitioner e-mailed Mr. Prendergast stating that it understood the

situation, appreciated Mr. Prendergast's prompt action, and would wait for his further report on the matter. Ex. 22.

After hearing nothing further from Mr. Prendergast, on June 19, 2008 Petitioner again inquired about the '307 Application. Exs. 10, 23. Mr. Prendergast responded to this inquiry on June 19, 2008 stating that he would follow-up immediately and that he had been advised recently that an action on this matter was expected in the near future. Ex. 23. Then, on June 20, 2008, Mr. Prendergast wrote a memo to the Brinks Hofer docketing department falsely reporting that Petitioner had authorized him to abandon the '307 Application. Ex. 11. No such authorization was ever given by Petitioner. Siller Dec., ¶ 27; Fukasu Dec., ¶ 10.

#### **J. Petitioner's Actions after Learning of the Abandonment**

On September 25, 2008 Brinks Hofer informed Petitioner that the '307 Application had gone abandoned. Siller Dec., ¶ 28. After Petitioner learned of and digested the unauthorized abandonment, it decided to choose alternate counsel, the undersigned's firm, to handle the petition to revive the '307 Application. After further investigation, Petitioner specifically decided to retain Oblon Spivak to file a Petition to Revive for the '307 Application and four other applications.<sup>4</sup> The files arrived at Oblon Spivak on December 17, 2008, during the holiday season. The five petitions, including the Petition to Revive the '307 Application, were filed on February 10, 2009.

#### **K. Illinois Investigation into Mr. Prendergast**

Since Petitioner filed its February 2009 Petition to Revive the '307 Application, a report was filed by the Registration and Disciplinary Commission with the Supreme Court of Illinois concerning Mr. Prendergast and his pattern of failure to prosecute patent applications, fabrication

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<sup>4</sup> The five applications are nos. 08/960,481; 08/652,284; 08/738,435; 08/740,521 and 09/139,307.

of evidence, and false statements in at least 24 cases over a 10 year period.<sup>5</sup> Ex. 12. Although the report does not specifically identify all 24 applications, it is believed that one of the 24 cases referred to in that report is the '307 Application. Consistent with the proceedings in the '307 Application, the report establishes that, "*without his clients' knowledge or consent,*" these 24 applications became abandoned and misrepresentations were made to the clients. *Id.* at p. 2 (emphasis added).

Thus, as confirmed by the Illinois Registration and Disciplinary Commission, for 10 years Mr. Prendergast spun a web of deceit that first hid the truth from clients like Petitioner, and then affirmatively prevented them from learning the truth after they inquired about the status of the applications. Like all of Mr. Prendergast's other victims, Petitioner had no intent to let the '307 Application go abandoned, and because it was not aware of the abandonment until the Fall of 2008, Petitioner similarly had no intent to delay in reviving the '307 Application.

## **ARGUMENT**

### **A. Legal Standard**

The Commissioner's dismissal of the Original Petition states "in view of the inordinate delay (almost 10 years) in resuming prosecution, there is a question whether the entire delay was unintentional." Decision at 2. While a delay of over one year may justify further inquiry as to why the delay was unintentional, *See*, MPEP § 711.03(c)(II)(D), the dismissal does not cite – and Petitioner is unaware of – any statutory or case law authority stating that the length of delay, by itself, is a sufficient basis for denying a petition to revive. Instead, unlike the '307 Application, in each case cited in the dismissal the applicants were found to have made knowing decisions which led to the abandonment. Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist.

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<sup>5</sup> Mr. Prendergast has since lost his license to practice law in Illinois. Ex. 13.

LEXIS 1159 (D. Minn. Jan. 27, 2005) (finding patentee knew quick action was needed to avoid abandonment but took no action); In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats 1989) ("The record clearly establishes that the applicants and their assignee through their representatives deliberately allowed this application to become abandoned" after record showed applicant affirmatively instructed attorney to abandon application); Lawman Armor Corp. v. Simon, 74 USPQ2d 1633, 1638 (E.D. Mich. 2005) (finding "no question of material fact that defendant had made a decision not to pursue the prosecution of his patent application" after Examiner called attorney to confirm abandonment, client had not paid attorney, and application only revived after introduction of competitor's product); Lumenyte Int'l Corp. v. Cable Lite Corp., 1996 U.S. App. LEXIS 16400 \*9 (Fed. Cir. July 9, 1996) (unpublished) (finding "clear and convincing evidence that Lumenyte intentionally abandoned the patent application when its officers thought that there was little chance for issuance" and application only revived after introduction of competitor's product); New York Univ. v. Autodesk, Inc., 495 F. Supp. 2d 369 (S.D.N.Y. 2007) (finding applicant knew of Office Action but did not file a response and attorney confirmed abandonment with Examiner).

The facts at issue here are strikingly different from the facts in any of the above-cited cases. Here, Petitioner was not aware that the '307 Application had gone abandoned. Fukasu Dec., ¶¶ 7-9; Siller Dec., ¶ 23. Petitioner did not instruct its attorneys to abandon the case. Fukasu Dec., ¶ 10; Siller Dec., ¶¶ 27, 30. Unlike Lawman Armor, Petitioner did not attempt to revive the case only after learning of a competitor's product and had no dispute over fees with Brinks Hofer. Siller Dec., ¶ 30. Instead, Petitioner's well regarded law firm Brinks Hofer had procedures in place to regularly remind its attorneys to take actions needed to respond to PTO actions. Despite the absence of any intentional acts by Petitioner or Petitioner's firm, a single

attorney through a pattern of deceptive acts caused the '307 Application to become abandoned and remain abandoned for years.

While a party is generally bound by the actions of its attorney, the courts and PTO have recognized exceptions to this rule. One exception is when the very attorney the client relies upon for expertise and wise counsel instead deceives the client. See, e.g., L.P. Steuart, Inc. v. Matthews, 329 F.2d 234, 235 (D.C. Cir. 1964), cert. denied, 379 U.S. 824 (1964); Jackson v. Washington Monthly Co., 569 F.2d 119, 123 (D.C. Cir. 1977); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (Trademark Trial & App. Bd. 1992); In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

In re Lonardo<sup>6</sup> is a leading example of the Commissioner applying the exception to a case in which a patent attorney concealed the abandonment of a patent application and deceived the applicants into believing that the application was still pending at the PTO. Although Lonardo was decided under the stricter unavoidable delay standard, it is noteworthy that the Commissioner revived a patent application after fourteen years of abandonment, on the basis that the petitioner had been intentionally deceived by his attorney. See, In re Lonardo, 17 USPQ2d at 1455-58 (emphasis added). The attorney in Lonardo, unbeknownst to the petitioner, allowed the patent application to go abandoned. When Mr. Lonardo inquired about the status of the application, the attorney concealed the abandonment and misled Mr. Lonardo into believing that the application was still pending at the PTO. In that case, the Commissioner found that the attorney's lack of diligence was not chargeable to the petitioner because of the "attorney's

---

<sup>6</sup> The Federal Circuit has addressed the Lonardo decision, stating that it is not bound by the decision. Huston v. Ladner, 973 F.2d 1564, 1567 (Fed. Cir. 1992). Importantly, though, the Federal Circuit did not reject or even criticize the Lonardo decision. Rather, it simply did not apply Lonardo because the case before it was factually distinguishable. Id. Huston dealt with a situation in which the attorney did not understand the substantive law. Huston did not address a situation in which an attorney intentionally deceived the applicant. The Federal Circuit's decision to not apply Lonardo to Huston does not mean Lonardo is not good law; it simply means that Lonardo must be applied to factually similar cases, those in which the attorney intentionally deceived the client.



intentional deception of his client.” *Id.* at 1458 (emphasis added). Thus, an attorney’s lack of diligence or delay should not be charged to the petitioner if the attorney intentionally deceived his/her client with respect to the prosecution of the patent application. That is precisely the situation in the ‘307 Application.

**B. Period (1)**

The Commissioner is correct in stating that the question for period (1) is “whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional.” Decision at 2. The dismissal also seeks further evidence that the initial delay was not due to a deliberate course of action. As discussed above, the cases cited in the dismissal are readily distinguishable from the present case because, in each cited case, there was a deliberate decision by the applicant to abandon the application. In contrast, it is undisputed that Petitioner did not make a deliberate decision to abandon the ‘307 Application but, rather, was the victim of fraud and deceit.

**1. Alps Was the Party with the Authority to Reply in 1999**

The Commissioner further states that the question for Period (1) is “whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional.” Alps, as assignee of the ‘307 Application, was the party with the authority to reply to the Notice of Allowability and Notice of Allowance to avoid abandonment in 1999. Supp. Fukasu Dec., ¶ 2.

**2. Petitioner Did Not Intend to Abandon the ‘307 Application and Took Steps to Revive the Application Upon Learning of its Abandonment**

As discussed in the Original Petition and this Renewed Petition, Petitioner was not informed that Mr. Prendergast had not filed corrected formal drawings or paid the issue fee and that the ‘307 Application had gone abandoned. Fukasu Dec., ¶¶ 7-9; Siller Dec. ¶¶ 16, 21, 23.

Absent knowledge of the failure to file the drawings and pay the issue fee, Petitioner can not be found to have taken a deliberate course of action to abandon the '307 Application. Furthermore, to find that Petitioner intentionally delayed based on its inaction would be contrary to the relevant case law. The “inaction” inquiry presupposes knowledge of the action that could have been taken. For example, in New York Univ. v. Autodesk, although the applicants were aware of the outstanding Office Action, the application became abandoned through NYU’s inaction – failure to instruct its attorney to respond to the Office Action. A similar case of inaction is evident in Lawman Armor v. Simon where the applicant made a conscious decision to abandon the application. Crucially, in these cases, and in contrast to the present case, the applicants were aware that an action needed to be taken to continue prosecution of the application yet chose not to take that action. Here, in contrast, Alps was informed by Mr. Prendergast that he would respond to the Notice of Allowability and Notice of Allowance by filing the corrected drawings and paying the issue fee (Ex. 1), and Alps did not request Mr. Prendergast not to do so (Fukasu Dec. ¶ 10).

Petitioner diligently prosecuted this case to the point of receiving a Notice of Allowance, based on the information provided by Mr. Prendergast. When Mr. Prendergast kept Petitioner properly informed, it is undisputed that Petitioner acted diligently and promptly to file a response at the PTO.

### **3. The Actions of Brinks Hofer**

Mr. Prendergast was designated by Brinks Hofer as the “responsible attorney” for prosecution of the '307 Application. Mr. Prendergast, as the responsible attorney, received numerous reminders relating to the '307 Application. Siller Dec., ¶¶ 6, 12, 17, 20, 21. Mr. Prendergast apparently gave false information to the docketing department regarding the status

of the '307 Application. Id., ¶¶ 6, 18-21. Brinks Hofer was led to believe, through Mr. Prendergast's false statements and his affirmative steps to hide the actual status of the application, that the '307 Application was being actively prosecuted. Id.

Brinks Hofer followed its normal procedures in assigning the '307 Application, in docketing due dates, and in sending out reminders concerning those due dates. This system was designed to provide for successful prosecution of patent applications by alerting attorneys to due dates. Siller Dec., ¶ 15. Mr. Prendergast, however, deceived Brinks Hofer, effectively disabled the Brinks Hofer docketing system, and allowed the '307 Application to become abandoned. Mr. Prendergast's fraudulent actions are not chargeable to Petitioner. In re Lonardo, 17 USPQ2d at 1458. Moreover, to the extent Petitioner's firm, Brinks Hofer, can have any intent, the firm clearly did not intend to abandon the application or delay in filing corrected drawings or paying the issue fee.

### **C. Period (2)**

Between 1999 and 2006, Petitioner awaited action by the PTO in the '307 Application. Petitioner had no idea that the '307 Application had gone abandoned as Mr. Prendergast failed to inform Petitioner of this critical fact. Instead, Petitioner relied on its U.S. patent counsel to inform it of any further developments in the case and any actions that needed to be taken. Supp. Fukasu Dec., ¶ 4. Petitioner also had no independent mechanism for identifying unusually long periods of inactivity in its cases. Id. There too, Petitioner reasonably relied on its U.S. counsel, counsel who had expertise in U.S. patent procedure, for guidance.

Eventually, after a 2006 internal review of its cases that had been pending for several years without action (Ex. 7; Supp. Fukasu Dec., ¶ 5), Petitioner asked Brinks Hofer about the status of the '307 Application (Ex. 8). At that point, Mr. Prendergast affirmatively misled

Petitioner by advising them that the application had been lost by the PTO and that he was taking steps to move prosecution forward. Once the abandonment was finally revealed in the fall of 2008, Petitioner moved with dispatch to file a Petition to Revive in early 2009.

At the same time, Petitioner's firm Brinks Hofer also acted reasonably. As discussed above and in greater detail in Mr. Siller's Declaration, Brinks Hofer had a docketing system in place to repeatedly remind attorneys of all due dates. Yet Mr. Prendergast took affirmative steps to defeat the docketing system. The '307 Application was thus unfortunately one of a string of cases, as independently reported by the Illinois Bar, where Mr. Prendergast misled his clients. Under the PTO's own case law in In re Lonardo, an applicant is not responsible for, or bound by, the acts of its counsel when that counsel committed fraud. Therefore, if the entire period between 1999 and 2009 must be considered, Petitioner had no intent to delay filing a petition to revive and it respectfully submits that this Petition to Revive the unintentionally abandoned application should be granted.

Moreover, Petitioner further submits that the relevant period for measuring delay in the present petition is from the date on which Petitioner *learned* of the abandonment of the '307 Application. This is consistent with the cases cited in the Decision. For example, in Lawman Armor, the court measured the delay from the date the court determined Mr. Simon knew of the Office Action. 74 USPQ2d at 1635. In that case, the court held that Mr. Simon had at least constructive knowledge of the Office Action because his attorney received the Office Action but did not respond and Mr. Simon was bound by the acts of his agent. Id. at 1637. While superficially this case is in some ways similar to the present petition, there are fundamentally important differences. Alps had knowledge of the Notice of Allowability but believed, based on representations from Mr. Prendergast (Ex. 1), that the corrected formal drawings would be

submitted and the issue fee paid. Alps did not lose interest in the application, owe its attorneys money, or fail to leave a correspondence address with its attorneys as was the case in Lawman Armor.

When the “delay” in filing the initial petition is properly calculated, it amounts to a mere four months, much less than the periods in Lawman Armor and Autodesk. This is particularly reasonable considering the complex issues of fraud, the search for new counsel, the fact that over the period included the holiday season, and the filing of five petitions. Even if the time of delay is not calculated from the date of discovery, the mere passage of time should not be held against Petitioner. As discussed above, Petitioner was diligent in pursuing the ‘307 Application. The passage of time from the date of actual abandonment to the filing of the petition was due to the fraudulent acts of Mr. Prendergast, who first hid the abandonment from Petitioner and then affirmatively misled Petitioner into believing the ‘307 Application was still pending.<sup>7</sup>

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<sup>7</sup> Petitioner also notes the comment in the PTO’s Final Rule providing for unintentional abandonment. Specifically, the Office stated: “Section 1.137(d) specifies a time period within which a renewed petition pursuant to § 1.137 must be filed to be considered timely. So long as a renewed petition is timely filed under § 1.137(d) (including any properly obtained extensions of time), the Office will consider the delay in filing a renewed petition under ... § 1.137(b) ‘unintentional’ under § 1.137(b)3).” 62 Fed. Reg. 53131, 53159 (Oct. 10, 1997).

## **CONCLUSION**

Petitioner submits that, under the legal and factual circumstances set forth above and in the Declarations of Gustavo Siller, Jr. and Takao Fukasu, a finding that the entire delay in filing formal drawings and paying the issue fee was unintentional is appropriate. For the reasons set forth herein, Petitioner respectfully requests that the Commissioner grant this Renewed Petition to Revive the '307 Application under 37 C.F.R. § 1.137(b) as being unintentionally delayed.

Date: October 8, 2009

Respectfully submitted,



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Andrew M. Ollis  
Reg. No. 40,749  
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**Appendix A to Renewed Petition to Revive '307 Application - Exhibits**

1. June 14, 1999 facsimile from Prendergast to Manabe (Alps)
2. September 3, 1999 docket room manual logbook entry (redacted)
3. June 3, 1999 Notice of Allowability/Allowance & Notice of Draftsperson's Drawing Review
4. September 3, 1999 Prendergast Submission of Formal Drawings and Issue Fee
5. Copies of check and accounting receipts for Submission of Formal Drawings and Issue Fee
6. November 9, 1999 Notice of Abandonment
7. November/December 2006 Alps IP Department Form and Response (with translation)  
(redacted)
8. December 28, 2006 letter from Fukasu (Alps) to Siller
9. January 11, 2007 facsimile from Prendergast to Fukasu
10. 2007/2008 e-mail correspondence between Alps and Prendergast
11. June 20, 2008 file closure memo
12. Illinois Supreme Court Report regarding Prendergast license suspension
13. September 22, 2009 entry striking Prendergast name from the roll of attorneys licensed to  
practice law in Illinois
14. '307 Application docket sheet
15. Fukasu Declaration – February 5, 2009
16. Siller Declaration – October 2, 2009
17. Fukasu Supplemental Declaration – October 1, 2009
18. Skjerven article – 2003
19. Beverina (Oblon, Spivak) letter to David Belofsky (Belofsky & Belofsky) – September 4,  
2009

- 20. Belofsky letter to Beverina – September 4, 2009
- 21. Beverina letter to David Belofsky – September 8, 2009
- 22. July 2007 e-mail correspondence between Alps and Prendergast
- 23. June 19, 2008 e-mail from Prendergast to Takeda
- 24. Notice of Allowance checklist
- 25. October 2, 1998 letter from Prendergast to Manabe



# **Renewed Petition to Revive '307 Application**

## **Exhibit 1**

William F. Prendergast  
312-321-4242  
e-mail: wfp@brinkshofer.com

June 14, 1999

**VIA DHL COURIER**

Y. Manabe  
Manager  
Patent Application Administration Center  
ALPS ELECTRIC CO., LTD.  
1-7, Yukigaya-otsuka-cho  
Okaku, Tokyo, 145-8501  
JAPAN

**Re: U.S. Application Serial No. 09/139,307  
THERMAL HEAD  
Your Reference No. M-US96001  
Our File No. 9281/3130**

Dear Mr. Manabe:

I have enclosed a copy of the Notice of Allowance and attachments for the above-identified patent application. As you can see, we now have a due date of September 3, 1999 for paying the issue fee of \$1,210.00 and for filing new drawings. Unless I hear otherwise from you, I will pay the issue fee and file new formal drawings about one month before the due date.

The only other open issue in this application relates to the filing of a divisional, continuation, or continuation-in-part application for the above-identified invention. Unless I hear otherwise from you, I will assume that you do not wish to file any continuing applications.

Also, we have an ongoing duty throughout the pendency of this application to disclose material prior art to the Examiner. Please advise me if you are aware of any additional art that should be considered for citation.

Sincerely yours,



William F. Prendergast

WFP:mal  
Enclosures

**BRINKS  
HOFER  
GILSON  
& LIONE**

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INTELLECTUAL PROPERTY ATTORNEYS

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SAN JOSE, CA  
DULUTH, MI  
Arlington, VA



# **Renewed Petition to Revive '307 Application**

## **Exhibit 2**

Friday 3 September

246/119  
1999

~~9281/3130 Shinkwa - 61210 and "Formal Drawings" 9.8.99 GS/WFP/X~~

REDACTED

# **Renewed Petition to Revive '307 Application**

## **Exhibit 3**



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/139,307	08/24/98	SHIRAKAWA	T 9281/G130

WILLIAM F PRENDERGAST  
BRINKS HOFER GILSON & LIONE  
P O BOX 10395  
CHICAGO IL 60610

MMS1/0603

EXAMINER

TECHNICAL  
ART UNIT PAPER NUMBER 4

2861  
DATE MAILED:

06/02/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE OF ALLOWABILITY

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

- ☐ This communication is responsive to \_\_\_\_\_
- ☒ The allowed claim(s) is/are 1-8
- ☐ The drawings filed on \_\_\_\_\_ are acceptable.
- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☒ received in Application No. (Series Code/Serial Number) 8/697,153
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.
- ☒ Applicant MUST submit NEW FORMAL DRAWINGS
- ☐ because the originally filed drawings were declared by applicant to be informal.
- ☒ including changes required by the Notice of Draftperson's Patent Drawing Review, PTO-948, attached hereto on Paper No. \_\_\_\_\_
- ☐ including changes required by the proposed drawing correction filed on \_\_\_\_\_, which has been approved by the examiner.
- ☐ including changes required by the attached Examiner's Amendment/Comment.
- ☒ including missing figs 7A, 7B. Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftperson.

- ☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Interview Summary, PTO-413
- ☐ Examiner's Amendment/Comment
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☒ Examiner's Statement of Reasons for Allowance

Huan Tran  
Primary Examiner

**DETAILED ACTION**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/697,153, filed on 08/20/96.

***Oath/Declaration***

2. Receipt is acknowledged of the executed Declaration and the appropriate filing fee.

***Drawings***

3. The drawings are objected to because Figs. 7A and 7B are missing from the 5 sheets of drawings filed which include Figs. 1-5, 6A-6C, 8 and 9. Correction is required.

***Allowable Subject Matter***

4. Claims 1-8 are allowed.

5. The following is an examiner's statement of reasons for allowance:

Prior art of record, in particular prior art to Shirakawa (US Patent No. 5,477,266) does not teach or suggest a second interlayer insulation layer comprised of insulating ceramic formed on the upper surface of the first interlayer insulation layer. Figs. 1-4 of Shirakawa shows a thermal head and a method of manufacturing, wherein an

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interlayer insulating layer 15 is formed by a thermal oxidizing treatment of the conductive layer 13.

Fuyama et al. (US Patent No. 4,617,575) discloses a thermal head having an interlayer insulating layer disposed between first and second conductors layers.

Saito (US Patent No. 4,451,835) discloses a thermal head having an extended common electrode layer 7 connected to a common electrode layer 11 through through hole 11.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."



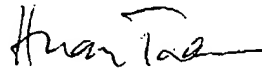
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan Tran whose telephone number is (703)308-0749.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist of the Technology Center whose telephone number is (703) 308-1782. The facsimile numbers for Technology Center 2800 are (703) 308-7722, (703) 308-7724, (703) 308-7382.



Huan H. Tran

Primary Examiner

Art Unit 2861

hht

June 2, 1999

<b>Notice of References Cited</b>			Application No. <b>09/139,307</b>		Applicant(s) <b>Shirakawa et al.</b>	
			Examiner <b>Huan Tran</b>		Group Art Unit <b>2861</b>	
Page 1 of 1						

U.S. PATENT DOCUMENTS						
*	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	
x	A	4,451,835	05/84	Saito	347	208
x	B	4,817,575	10/86	Fuyama et al.	347	208
x	C	5,477,286	12/95	Shirakawa	347	208
	D					
	E					
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FOREIGN PATENT DOCUMENTS						
*	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS	
*	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)
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	V
	W
	X

\* A copy of this reference is not being furnished with this Office action.  
(See Manual of Patent Examining Procedure, Section 707.05(a).)

9/139307

NOTICE OF DRAFTPERSON'S  
PATENT DRAWING REVIEWThe drawing filed (insert date) 8/24/98 are:A. ☒ not objected to by the Draftperson under 37 CFR 1.84 or 1.152.B. ☒ objected to by the Draftperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings where necessary. Corrected drawings must be submitted according to the instructions on the back of this notice.

<p>1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:</p> <p>Black ink. Color.</p> <p><input type="checkbox"/> Color drawing are not acceptable until petition is granted.</p> <p>Fig(s) _____</p> <p><input type="checkbox"/> Pencil and non black ink is not permitted. Fig(s) _____</p> <p>2. PHOTOGRAPHS. 37 CFR 1.84(h)</p> <p><input type="checkbox"/> Photographs are not acceptable until petition is granted.</p> <p><input type="checkbox"/> 3 full-tone sets are required. Fig(s) _____</p> <p><input type="checkbox"/> Photographs not properly mounted (must be on board or photographic double-weight paper). Fig(s) _____</p> <p><input type="checkbox"/> Poor quality (half-tone). Fig(s) _____</p> <p>3. TYPE OF PAPER. 37 CFR 1.84(e)</p> <p><input type="checkbox"/> Paper not flexible, strong, white and durable.</p> <p>Fig(s) _____</p> <p><input type="checkbox"/> Erasures, alterations, overwritings, interlineations, folds, copy machine marks not acceptable. (too thin)</p> <p><input type="checkbox"/> Mylar, vellum paper is not acceptable (too thin).</p> <p>Fig(s) _____</p> <p>4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:</p> <p><input type="checkbox"/> 21.0 cm by 29.7 cm (DIN size A4)</p> <p><input type="checkbox"/> 21.6 cm by 27.9 cm (8 1/2 x 11 inches)</p> <p><input type="checkbox"/> All drawings sheets not the same size.</p> <p>Sheet(s) _____</p> <p>5. MARGINS. 37 CFR 1.84(g): Acceptable margins:</p> <p>Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm</p> <p>SIZE: A4 Size</p> <p>Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm</p> <p>SIZE: 8 1/2 x 11</p> <p><input type="checkbox"/> Margins not acceptable. Fig(s) _____</p> <p><input type="checkbox"/> Top (T) _____ Left (L) _____</p> <p><input type="checkbox"/> Right (R) _____ Bottom (B) _____</p> <p>6. VIEWS. CFR 1.84(h)</p> <p>REMINDER: Specification may require revision to correspond to drawing changes.</p> <p><input type="checkbox"/> Views connected by projection lines or lead lines.</p> <p>Fig(s) _____</p> <p>Partial views. 37 CFR 1.84(h)(2)</p> <p><input type="checkbox"/> Brackets needed to show figure as one entity.</p> <p>Fig(s) _____</p> <p><input type="checkbox"/> Views not labeled separately or properly.</p> <p>Fig(s) _____</p> <p><input type="checkbox"/> Enlarged view not labeled separately or properly.</p> <p>Fig(s) _____</p>	<p>7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)</p> <p><input type="checkbox"/> Hatching not indicated for sectional portions of an object.</p> <p>Fig(s) _____</p> <p><input type="checkbox"/> Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____</p> <p>8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)</p> <p><input type="checkbox"/> Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned, so that the top becomes the right side, except for graphs. Fig(s) _____</p> <p><input type="checkbox"/> Views not on the same plane on drawing sheet. Fig(s) _____</p> <p>9. SCALE. 37 CFR 1.84(k)</p> <p><input type="checkbox"/> Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction.</p> <p>Fig(s) _____</p> <p>10. CHARACTER OF LINES, NUMBERS, &amp; LETTERS. 37 CFR 1.84(l)</p> <p><input checked="" type="checkbox"/> Lines, numbers &amp; letters not uniformly thick and well defined, clean, durable and black (poor line quality).</p> <p>Fig(s) <u>8</u></p> <p>11. SHADING. 37 CFR 1.84(m)</p> <p><input type="checkbox"/> Solid black areas pale. Fig(s) _____</p> <p><input type="checkbox"/> Solid black shading not permitted. Fig(s) _____</p> <p><input type="checkbox"/> Shade lines, pale, rough and blurred. Fig(s) _____</p> <p>12. NUMBERS, LETTERS, &amp; REFERENCE CHARACTERS. 37 CFR 1.84(p)</p> <p><input checked="" type="checkbox"/> Numbers and reference characters not plain and legible.</p> <p>Fig(s) <u>1, 2, 4, 9, 14, 10</u></p> <p><input checked="" type="checkbox"/> Figure legends are poor. Fig(s) <u>1, 4, 10</u></p> <p><input type="checkbox"/> Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(3) Fig(s) _____</p> <p><input type="checkbox"/> English alphabet not used. 37 CFR 1.84(p)(3) Fig(s) _____</p> <p><input type="checkbox"/> Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig(s) <u>5, 14, 3</u></p> <p>13. LEAD LINES. 37 CFR 1.84(q)</p> <p><input type="checkbox"/> Lead lines cross each other. Fig(s) _____</p> <p><input type="checkbox"/> Lead lines missing. Fig(s) _____</p> <p>14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)</p> <p><input type="checkbox"/> Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Fig(s) _____</p> <p>15. NUMBERING OF VIEWS. 37 CFR 1.84(u)</p> <p><input type="checkbox"/> Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____</p> <p>16. CORRECTIONS. 37 CFR 1.84(w)</p> <p><input type="checkbox"/> Corrections not made from PTO-948 dated _____</p> <p>17. DESIGN DRAWINGS. 37 CFR 1.152</p> <p><input type="checkbox"/> Surface shading shown not appropriate. Fig(s) _____</p> <p><input type="checkbox"/> Solid black shading not used for color contrast.</p> <p>Fig(s) _____</p>
---	--

COMMENTS

REVIEWER

DATE

TELEPHONE NO.

ATTACHMENT TO PAPER NO.

PTO COPY



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

MM6175A00

WILLIAM F. PRENDERGAST  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO IL 60610

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/139,307	03/24/98	008	TRAN. H	03/24/99
First Named Applicant	SHIRAKAWA, 35 USC 154 (b) term ext. 4 - 4 days.			
TITLE OF INVENTION THERMAL HEAD				

ATTYS DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
2 9291/3130	347-200.000	T84	UTILITY	NO	\$1210.00	07/03/99

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT.  
PROSECUTION ON THE MERITS IS CLOSED.**

**THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.**

**HOW TO RESPOND TO THIS NOTICE:**

Review the SMALL ENTITY status shown above.  
If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- Pay FEE DUE shown above, or
- File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

- Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.
- All communications regarding this application must give application number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

PATENT AND TRADEMARK OFFICE COPY

# **Renewed Petition to Revive '307 Application**

## **Exhibit 4**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on September 3, 1999  
Date of Deposit

WILLIAM F. PRENDERGAST  
Name of Applicant, assignee or Registered Representative

  
Signature

Our Case No. 9281/3130

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Shirakawa et al.	)	
	)	
Serial No. 09/139,307	)	
	)	Examiner H. Tran
Filing Date: August 24, 1998	)	
	)	Group Art Unit No. 2861
For THERMAL HEAD	)	
	)	

**SUBMISSION OF FORMAL DRAWINGS**

Official Draftsman  
UNITED STATES PATENT AND TRADEMARK OFFICE  
Washington, D.C. 20231

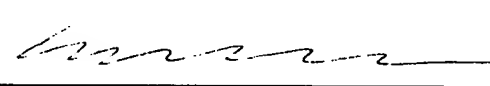
Dear Sir:

In response to the Notice of Allowability received with the Notice of Allowance and Issue Fee Due mailed June 3, 1999, Applicants hereby submit the enclosed 6 sheets of formal drawings.

Respectfully submitted,

Dated: 9/3/99

BRINKS HOFER GILSON & LIONE  
P.O. Box 10395  
Chicago, IL 60610  
312/321-4200

  
William F. Prendergast  
Registration No. 34,699  
Attorney for Applicants

**MAILING INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE. Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Issue Fee Receipt, the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

**CURRENT CORRESPONDENCE ADDRESS** (Note: Legibly mark-up with any corrections or use Block 1)

MM61/0603  
WILLIAM F PRENDERGAST  
BRINKS HOFER GILSON & LIONE  
P O BOX 10395  
CHICAGO IL 60610

Note: The certificate of mailing below can only be used for domestic mailings of the Issue Fee Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing.

**Certificate of Mailing**

I hereby certify that this Issue Fee Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Box Issue Fee address above on the date indicated below.

William F. Prendergast (Depositor's name)

*William F. Prendergast* (Signature)

September 3, 1999 (Date)

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/139,307	08/24/98	008	TRAN, H	2861 06/03/99
First Named Applicant: SHIRAKAWA, 35 USC 154(b) term ext. = 0 Days.				

**TITLE OF INVENTION** THERMAL HEAD

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
2	9281/3130	347-200.000	T84	UTILITY	NO	\$1210.00 09/03/99

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363). Use of PTO form(s) and Customer Number are recommended, but not required.

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47) attached.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1. BRINKS HOFER GILSON  
& LIONE  
2. \_\_\_\_\_  
3. \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)  
**PLEASE NOTE:** Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the PTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE ALPS ELECTRIC CO. LTD.

(B) RESIDENCE: (CITY & STATE OR COUNTRY) TOKYO, JAPAN

Please check the appropriate assignee category indicated below (will not be printed on the patent)

☐ individual ☐ corporation or other private group entity ☐ government

4a. The following fees are enclosed (make check payable to Commissioner of Patents and Trademarks):

☒ Issue Fee  
☒ Advance Order - # of Copies 10

4b. The following fees or deficiency in these fees should be charged to:

DEPOSIT ACCOUNT NUMBER 23-1925  
(ENCLOSE AN EXTRA COPY OF THIS FORM)

☒ Issue Fee  
☒ Advance Order - # of Copies 10

The COMMISSIONER OF PATENTS AND TRADEMARKS IS requested to apply the Issue Fee to the application identified above.

(Authorized Signature)

(Date)

09/03/99

NOTE: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending on the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND FEES AND THIS FORM TO: Box Issue Fee, Assistant Commissioner for Patents, Washington D.C. 20231

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMIT THIS FORM WITH FEE

# **Renewed Petition to Revive '307 Application**

## **Exhibit 5**



Case No. 4281/3130  
Applicant SHIRAKAWA ET AL.

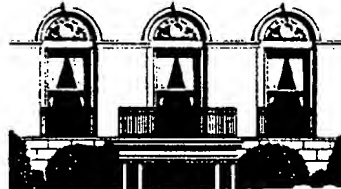
Hon. Commissioner of Patents & Trademarks  
Washington, D.C. 20231

Please acknowledge receipt of the below-identified:

PTOL-85B (dupl); Submission of Formal Drawings; 6  
Sheets Formal Drawings; Check for \$1,240 for Issue Fee  
and Patent Copies; Transmittal Letter (dupl.); Return Post  
Card.

BRINKS HOFER GILSON & LIONE  
By: W. F. Prendergast/mal

Serial No. 09/139,307  
Date of Mailing: September 3, 1999



BRINKS HOFER  
GILSON & LIONE

246702

INVOICE NO.	INVOICE DATE	DISB. CODE	INVOICE AMOUNT	ACCOUNT	DESCRIPTION
91351	09/02/99	41	1,240.00	09281 03130	PAYMENT OF ISSUE FEE AND COPIES OF PATENT
REMITTANCE ADVICE WILLIAM F. PRENDERGAST →			1,240.00		

**BRINKS HOFER  
GILSON & LIONE**

246702

INVOICE NO.	INVOICE DATE	DISB. CODE	INVOICE AMOUNT	ACCOUNT	DESCRIPTION
91351	09/02/99	41	1,240.00	09281 03130	PAYMENT OF ISSUE FEE AND COPIES OF PATENT
REMITTANCE ADVISE WILLIAM F. PRENDERGAS →			1,240.00		

**BRINKS HOFER  
GILSON & LIONE**

A PROFESSIONAL CORPORATION

NBC TOWER

455 NORTH CITYFRONT PLAZA DRIVE, SUITE 3600  
CHICAGO, IL 60611-5599

09/02/99

THE NORTHERN TRUST COMPANY  
CHICAGO, ILLINOIS 60675  
2-15/710

246702 246702

AMOUNT

\$ \*\*\*\*\*1,240.00

PAY:

ONE THOUSAND TWO HUNDRED FORTY AND 00/100 DOLLARS

COMMISSIONER OF PATENTS AND TRADEMARKS

TO THE  
ORDER  
OF

BRINKS HOFER  
GILSON & LIONE

*Anna L. Henderson*

⑈ 246702⑈ ⑆071000152⑆ 0000107012⑈

Security features included. Details on back.

# **Renewed Petition to Revive '307 Application**

## **Exhibit 6**



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/139,307	08/24/98	SHIRAKAWA	T 9281/3130

7542/1109  
WILLIAM F PRENDERGAST  
BRINKS HOFER GILSON & LIONE  
P O BOX 10395  
CHICAGO IL 60610

EXAMINER

TRIN, H  
ART UNIT PAPER NUMBER

DATE MAILED:

2861 05

11/09/99

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

- ☐ Applicant's failure to timely file a proper response to the Office letter mailed on \_\_\_\_\_.
  - ☐ A response (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_, which is after the expiration of the period for response (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - ☐ A proposed response was received on \_\_\_\_\_, but it does not constitute a proper response to the final rejection.  
(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).
  - ☐ No response has been received.
- ☒ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
  - ☐ The issue fee (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_.
  - ☐ The submitted issue fee of \$\_\_\_\_\_ is insufficient. The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_.
  - ☒ The issue fee has not been received.
- ☐ Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
  - ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of \_\_\_\_\_) were received on \_\_\_\_\_.
  - ☐ The proposed new formal drawings filed \_\_\_\_\_ are not acceptable.
  - ☐ No proposed new formal drawings have been received.
- ☐ The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on \_\_\_\_\_.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

Diane Terry  
Allowed Files Branch  
703-305-8203

# **Renewed Petition to Revive '307 Application**

## **Exhibit 7**

## Inquiry about Continued Foreign Application

(J) IP Division

11.23.2006

[Stamped by] Jinbo (Supervisor)

[Stamped by] Kato (Person in charge)

←

(H) IP Division

11.20.2006

[Stamped by] Kobayashi (Supervisor)

[Stamped by] Takeda (Person in charge)

US Patent Application No. 09/139,307 (M US96001) N

(JP 8-022475)

00-44699 [handwritten]

Above-titled matter has not had any progress for 5 years. We are considering to submit status inquiry to the USPTO. Please review the implementation condition of the current invention, life of technology, and examination results of the original Japanese application etc. Please inform IP Division whether we should continue the prosecution by December 11, 2006.

(Send by December 8)

(J) IP Division

11.29.06

[Stamped by] Jinbo (Supervisor)

[Stamped by] Kato (Person in charge)

→

(H) IP Division

11.30.2006

[Stamped by] Takeda (Person in charge)

1. Implementation condition at aforementioned country

DOS line heads are being mass-produced for  
also being shipped to the U.S.

**REDACTED**

having such heads are

2. Business condition of aforementioned case

This case uses a relatively basic structure and life of technology is likely to be at least three years or so.

3. Conclusion

☒ Continue the application (Submit status inquiry to the USPTO)

☐ Abandon the application

<Reasons for Continuation or Abandonment>

This is a beneficial patent in view of its practicability and its life of technology.

Director of Technology Division  
[Blank]  
(Stamp needed for abandonment)

外国出願継続に関する問合せ

(事)知的財産部門	
責任者	担当者
専任 UE11.29 神保	特許 UE11.29 加藤

(H)知的財産部門	
責任者	担当者
特許 UE11.29 加藤	知財 UE11.20 武田

US 特許出願 No. 161 / 129,207 (MUS4600) (N)

標記件は、5年間何ら進展がなく、USPTOへ状況伺い書の提出を検討中です。  
つきましては、本件発明の実施状況・技術寿命・基礎日本出願の審査結果等を確認の上、  
本件の手続継続の可否を2006年12月11日(H)知的財産部門まで連絡願います。

(事)知的財産部門	
責任者	担当者
専任 UE11.29 神保	特許 UE11.29 加藤

(H)知的財産部門 担当者
知財 UE11.20 武田

1. 当該国での実施状況

**REDACTED** PCS-ラインハートが重産中で、米国にも該ヘッドと  
搭載した装置が出願されている

2. 当該案件のビジネス状況

・本件は比較的早期構成と有しており、あと3年程度は技術寿命あり

3. 結論

☒ 出願を継続する (USPTOへ状況伺い書を提出)

☐ 出願を放棄する

<継続 or 放棄の理由>

実施性、技術寿命の点で、有効な特許である

技術部門長

(放棄の場合のみ要)

# **Renewed Petition to Revive '307 Application**

## **Exhibit 8**





**ALPS ELECTRIC CO., LTD.** INTELLECTUAL PROPERTY DEPARTMENT  
1-7 Yukigaya-Otsuka-Cho, Ota-ku, Tokyo, 145-8501, Japan  
Phone +81 3-5499-8054 Fax +81 3-5499-8055

ALPS2006-732  
December 28, 2006

Mr. Gustavo Siller, Jr.  
Brinks, Hofer, Gilson & Lione  
NBC Tower, Suite 3600  
455 North Cityfront Plaza Drive  
Chicago, Illinois 60611-5599  
USA

**Re: Request for Investigation of Current Status of U.S. Applications**

Dear Mr. Siller;

Regarding our U.S. patent applications mentioned in the following list, we have not received any documents and information for at least five years.

Application No.	Your File No.	Our File No.
08/652,284	9281-2231	FT US95002
08/738,435	9281-2281	FC US95004
08/912,967	9281-2419	FC US96016
09/139,307	9281-3130	M US96001

Please investigate the current status of these applications and let us know it as soon as possible.

Sincerely yours,

Takao Fukasu  
Senior Manager  
Intellectual Property Department

TF/at

**ALPS Confidential**

This information can be disclosed only to the above designated recipient(s) and shall be kept confidential, which are decided and authorized by the manager of I. P. Department.

# **Renewed Petition to Revive '307 Application**

## **Exhibit 9**

William F. Prendergast  
312.321.4242  
wfp@brinkshofer.com

VIA Fax No. 011 81 035 499 8055

January 11, 2007

T. Fukasu  
Manager  
Patent Application Administration Center  
ALPS ELECTRIC CO., LTD.  
1-7 Yukigaya-Otsuka-Cho  
Ota-ku, Tokyo 145-8501  
JAPAN

Re: Request For Status

Dear Mr. Fukasu:

Pursuant to your request of December 28, 2006 (ALPS 2006-732), we have requested an update from the United States Patent and Trademark Office regarding the referenced applications. I was advised that can expect an actions in the next 2-3 months. In view of the delay, I have requested for a formal response in writing that I will forward upon receipt. Apparently, the files were lost at the USPTO which resulted in the delay of their review.

Please let me know if you have any questions.

Sincerely,



William F. Prendergast



# **Renewed Petition to Revive '307 Application**

## **Exhibit 10**

akiko.9002812  
takeda/jh00/adm0/jp  
2008/05/19 16:40

宛先 "Prendergast, William" <WFP@brinkshofer.com>  
cc gsiller@brinkshofer.com  
cbrady@usebrinks.com  
bcc  
件名 Re: Request For Current Status [Very Important]

Dear Mr. Prendergast,

With respect to the following cases, would you please contact the USPTO to accelerate an examination procedure of these cases ?  
We have not received any action from the USPTO for a quite long time.

Application No.	Filing Date	Our File No.	Remarks
08/652284	1996/05/21	FT US95002	<Important> This application concerns an infringement case of a certain company.
08/738435	1996/10/24	FC US95004	<Important> This application will be transferred to a certain company.
09/139307	1998/08/24	M US96001	
08/912967	1997/08/01	FC US96016	

Thank you in advance.

Sincerely,  
Akiko Takeda

"Prendergast, William" <WFP@brinkshofer.com>



"Prendergast, William"  
<WFP@brinkshofer.com>  
2008/03/03 22:56

宛先 <akiko.takeda@jp.alps.com>  
cc "Siller, Gus" <gsiller@brinkshofer.com>  
<junji.kobayashi@jp.alps.com>  
件名 Re: Request For Current Status [Very Important]

Thank you for your email. I will follow up with the PTO. I expect an action shortly on this matter. I will keep you advised.  
Bill Prendergast

----- Original Message -----

From: akiko.takeda@jp.alps.com <akiko.takeda@jp.alps.com>  
To: Prendergast, William  
Cc: Siller, Gus; junji.kobayashi@jp.alps.com <junji.kobayashi@jp.alps.com>  
Sent: Sun Mar 02 23:54:48 2008  
Subject: Re: Request For Current Status [Very Important]

Dear Mr. Prendergast,

Do you have any update on this application ?  
As we told you before, we desire acceleration of the procedure of the application No. 08/738,435 (9281-2881/FC US95004) because this application concerns an infringement case of a certain company.  
Please advise us by return.

Sincerely,  
Akiko Takeda

\*\*\*\*\*  
Akiko Takeda  
Intellectual Property Department  
ALPS ELECTRIC CO., LTD.  
TEL: 81+3+5499+8054  
FAX: 81+3+5499+8055  
E-Mail: akiko.takeda@jp.alps.com  
\*\*\*\*\*

"Prendergast,  
William"  
<WFP@brinkshofer.com>

2007/07/14 06:47

<akiko.takeda@jp.alps.com>

宛先  
cc  
件名

Request For Current Status

Re: Application No. 08/738,435 (9281-2881/FC US95004)

Ms. Takeda,

Thank you for your email to Ms. Hall of July 11, 2007 regarding the referenced applications. We are currently investigating the matter with US PTO and will make every effort to advance the prosecution of the referenced applications. I have scheduled a call with supervisor at the PTO for next week to attempt to get this matter resolved on a urgent basis. Please let me know if you have any questions.

William Prendergast

William Prendergast  
Intellectual Property Attorney  
Brinks Hofer Gilson & Lione  
NBC Tower, Suite 3600  
455 North Cityfront Plaza Drive  
Chicago, IL 60611-5599  
312.321.4242  
312.321.4299 F  
wprendergast@usebrinks.com  
www.usebrinks.com

(Embedded image moved to file:  
pic15724.bmp)

[Please Note: This message is intended for the individual or entity named above and may constitute a privileged and confidential communication. If you are not the intended recipient, please do not read, copy, use, or disclose this message. Please notify the sender by replying to this message, and then delete the message from your system. Thank you.]

# **Renewed Petition to Revive '307 Application**

## **Exhibit 11**

# MEMORANDUM

BRINKS  
HOFER  
GILSON  
& LIONE

TO: U.S. Docket Dept.  
[If closing matter in Acctg, select Acctg Dept.]  
[If closing matter in Acctg, select Records Dept.]

FROM: WFP

DATE: June 20, 2008

RE: Abandon/Close Authorization

Please Abandon/Close the following matter:

Client/Matter No: 92811 2919 9281/3130  
Client Name: Aps Eler  
Matter Name: Angle Detent Thermal Head

If applicable, this client/matter no. has been abandoned/closed in favor of:  
client/matter no.

This matter is being closed for the following reason:


- ☐ Client instructions (letter or email attached or in file)  
☐ File being transferred (letter or email attached or in file)  
☐ Lack of client instructions (letter(s) or email(s) attached or in file)  
☐ Other: \_\_\_\_\_

This file is a:

- ☐ Prosecution Case  
☐ Litigation Case  
☐ Other

Accounting System: Unless checked, this matter will only be closed in the docket system.

- ☐ Close this matter in **Accounting (copy to Accounting if checked)**  
**Accounting:** Please close matter 60 days after date of signature.

  
\_\_\_\_\_  
Attorney Signature

  
\_\_\_\_\_  
Date

**Note:** It is the attorney's responsibility to obtain a letter from the client or send a confirming letter to the client concerning these instructions.



# **Renewed Petition to Revive '307 Application**

## **Exhibit 12**

IN THE SUPREME COURT OF ILLINOIS

In the Matter of:

**WILLIAM FRANCIS PRENDERGAST,**

Supreme Court No. M.R.

Attorney-Movant,

Commission No. 09 DC 1005

No. 6203730.

STATEMENT OF CHARGES PURSUANT TO  
SUPREME COURT RULE 762(a)

Jerome Larkin, Administrator of the Attorney Registration and Disciplinary Commission, by his attorney Scott Renfroe, pursuant to Supreme Court Rule 762(a), states that on the date William Francis Prendergast (hereinafter "Movant") filed a motion requesting that his name be stricken from the Roll of Attorneys, the Inquiry Board had voted to file a complaint against Movant charging that in at least 24 cases over a ten-year period Movant failed to prosecute patent applications for at least nine clients, then fabricated documents and made false statements to conceal his inactivity from his clients, referring counsel, a federal agency and his co-workers. Had Movant's conduct been the subject of a hearing, the Administrator would have introduced the evidence described below, and that evidence would have clearly and convincingly established the following conclusions of misconduct:

I. FACTUAL BACKGROUND

Movant's admissions, testimony from former co-workers, clients, and referring counsel, and various documents, including docket reports, time and billing records, expense reports, computer records, applications, status reports and items of correspondence, would have established the following facts:

*A. Introduction and Background Information*

1. Between November 8, 1990, when Movant was licensed to practice law in Illinois

PAGE 2:

and began working at an intellectual property law firm in Chicago, and August 14, 2008, when that firm terminated his employment, Movant concentrated his practice in the preparation and prosecution of patent applications before the United States Patent and Trademark Office ("USPTO")

2. When an applicant submits a patent application to the USPTO, that application is assigned to an examiner for review. Frequently, the examiner will identify questions or

issues that the applicant must address, and those questions or issues are brought to the applicant's attention by way of a written request for action. The applicant is usually required to respond to the USPTO's request within six months, and, unless a response is submitted within that period, the application is deemed abandoned and the applicant may no longer pursue it. The USPTO allows applicants to petition for revival of abandoned applications if the applicant can demonstrate that the abandonment was either unintentional or unavoidable.

*B. Movant's Abandonment of at Least 24 Client Patent Applications*

3. Beginning in approximately 1998, Movant, without his clients' knowledge or consent, abandoned the prosecution of at least 24 patent applications for which he was responsible (some of which are discussed in more detail below) by failing to respond to written inquiries issued by the USPTO. When the USPTO issued notices of abandonment relating to many of those applications, Movant concealed his inactivity on the matters by falsely advising his firm's docketing department that the patent application had been abandoned at his clients' direction.

*C. Pattern of Misrepresentations to Conceal Abandonment of Patent Applications*

4. Between at least 2000 and 2006, in an effort to conceal his abandonment of patent applications for at least nine clients, Movant engaged in a pattern of conduct designed to create

PAGE 3:

the false impression that abandoned applications were pending. That conduct included the fabrication of purported responses to USPTO requests for information and the provision of other false information to clients and referring counsel by way of telephone conversations, letters, electronic communications (e-mail), and, in at least one case, by the staging of what Movant falsely claimed was a telephone interview between his client, referring counsel in England and an imposter claiming to be a USPTO examiner.

*i. Misrepresentations to Client and Referring Counsel – Client "A"*

5. More specifically, in connection with just one patent application, which Movant abandoned without his client's consent by failing to respond to the USPTO's June 22, 1998 request for information, Movant's deceptive conduct included:

(a) sending a November 29, 2000 letter to an attorney in England (who had referred the client matter to Movant's law firm) that enclosed a fabricated document purporting to show that the USPTO continued to have questions about the application. In fact, the fabricated document was an alteration of a genuine USPTO request from the same case, dated November 17, 1997, and Movant knew that the application was no longer pending, having received notice that the USPTO considered the application abandoned as of January 20, 1999;

(b) sending January 26, March 15 and November 16, 2001 letters to referring counsel containing false information about actions Movant claimed to be taking in connection with the application;

(c) sending a November 18, 2001 letter to referring counsel containing a fabricated document reflecting work that Movant falsely claimed to have recently done on the application;

(d) sending a January 26, 2002 facsimile transmission to referring counsel containing a fabricated document falsely purporting to be work done by another attorney at Movant's firm;

PAGE 4:

(e) sending two September 30, 2002 letters to referring counsel containing false information about actions Movant claimed to be taking in the case, and enclosing a fabricated document purporting to have been generated by the USPTO;

(f) sending a November 20, 2002 letter to referring counsel in which Movant falsely claimed to have met earlier that month with a USPTO examiner in connection with the client's application;

(g) sending a January 27, 2003 letter to referring counsel in which Movant falsely claimed that a USPTO examiner was considering scheduling an interview with the client;

(h) sending an August 19, 2004 letter to referring counsel in which Movant falsely claimed that the delay in considering the application (which had actually been abandoned almost six years earlier) was due to the USPTO's relocation of its offices;

(i) sending a November 18, 2004 facsimile to the client attaching a fabricated USPTO facsimile cover sheet addressed to Movant and a note, purporting to be addressed to Movant from a USPTO examiner, apologizing for the delay in processing the client's application and promising additional action within the next several months;

(j) over the course of several weeks, scheduling and then conducting what Movant claimed was a telephone interview on January 26, 2006 between the client, referring counsel in England and what was actually an imposter pretending to be a USPTO employee; and

(k) sending a March 15, 2006 facsimile transmission to the referring attorney of a fabricated document that purported to be a USPTO summary of the purported January 26, 2006 interview.

ii. *Fabricated Documents and False Statements to Co-Workers – Client "B"*

6. In connection with a second client's patent application, Movant did not pay a fee

PAGE 5:

that was due on October 15, 1999, and the USPTO deemed the client's application abandoned as of May 24, 2000. Between November 3, 2003 and July 9, 2007, Movant sent approximately 20 e-mails to other attorneys at his firm in response to their inquiries about the status of the client's application. In those messages, Movant falsely claimed to have had continuing contact with the USPTO about the application. On July 25, 2007, Movant sent a voice mail attachment to an e-mail message to another firm attorney. That voice mail message, which Movant created by calling his office from his own cell phone, purported to be from "Examiner Williams" and falsely claimed that the USPTO had "granted your petition and will be mailing it out today." On September 11, 2007, in response to continued inquiries from other attorneys at the firm, Movant created and sent one of his co-workers what purported to be an August 9, 2007 "notice of rescinded abandonment" and an August 28, 2007 cover letter to the client enclosing that purported notice. In fact, Movant fabricated the purported notice by pasting a false date on an actual USPTO notice of rescinded abandonment dated May 24, 1999.

*D. False Statement to USPTO and Fabrication of Return Receipt Postcards*

7. Movant received notice that the USPTO considered a client's application to be abandoned as of July 24, 2007. During April and May of the following year, after another attorney in the firm became aware of the application's abandonment, Movant falsely told that attorney that the USPTO had misplaced both a June 6, 2007 response Movant claimed to have submitted replying to the USPTO's original inquiry, and an August 8, 2007 petition Movant claimed to have filed seeking to withdraw the allegedly improper abandonment. On May 28, 2008, Movant submitted what he termed a "resubmission" of the purported June 6, 2007 response and August 8, 2007 petition, to which he attached not only documents bearing those dates but also fabricated return-receipt postcards purporting to reflect that the USPTO had

PAGE 6:

received the original mailings at about the time Movant claimed they had been mailed. Movant fabricated the postcards by cutting and pasting actual date-stamps from legitimate postcards on file at the firm. The USPTO later granted the request to rescind the application's abandonment.

8. In at least five other cases between 1999 and 2008, Movant fabricated return-receipt postcards that falsely reflected that the USPTO had received mailings from Movant.

## II. CONCLUSIONS OF MISCONDUCT

9. By the reason of the conduct described above, Movant has engaged in the following misconduct:

- a. failure to act with reasonable diligence and promptness in representing a client, in violation of Rule 1.3 of the Illinois Rules of Professional Conduct;
- b. conduct involving dishonesty, fraud, deceit or misrepresentation, in violation of Rule 8.4(a)(4) of the Illinois Rules of Professional Conduct;
- c. conduct that is prejudicial to the administration of justice, in violation of Rule 8.4(a)(5) of the Illinois Rules of Professional Conduct; and
- d. conduct which tends to defeat the administration of justice or bring the courts or the legal profession into disrepute, in violation of Supreme Court Rule 770.

Respectfully  
submitted,

Jerome  
Larkin,  
Administrator  
Attorney  
Registration  
and  
Disciplinary  
Commission

Scott Renfroe  
Counsel for the Administrator  
Attorney Registration and Disciplinary Commission  
130 East Randolph Drive, Suite 1500  
Chicago, Illinois 60601-6219  
Telephone: (312) 565-2600

By: Scott  
Renfroe

# **Renewed Petition to Revive '307 Application**

## **Exhibit 13**

**M.R.23191 - In re: William Francis Prendergast. (September 22, 2009)**

Disciplinary Commission.

The motion by William Francis Prendergast to strike his name from the roll of attorneys licensed to practice law in Illinois pursuant to Supreme Court Rule 762(a) is allowed, effective immediately.

Order entered by the Court.



# **Renewed Petition to Revive '307 Application**

## **Exhibit 14**



Patent: 9281-3130 , United States, Regular, National, Continuation-In-Part

## Patent Data

Docket Number	9281-3130
Country	United States
Case Type	Regular
Relation Type	Continuation-In-Part
Filing Type	National
Sub Case	
Status	Inactive
Sub Status	Closed
Parent Country	
Patent Family	
Application Number	09/139,307
Patent Number	
Publication Number	
Pay Maint Fee	No

Supervising Atty	Gustavo Siler, Jr.
Responsible Atty	Vincent J. Gnoffo
Agent	NEW
Client	Alps Electric Co., Ltd.
Assignee	Alps Electric Co., Ltd.
Reference Number	9281-3130
First Filing Date	8/20/1996
Sub Status Date	
Parent Filing Date	8/20/1996
Parent Grant Date	
Application Date	8/24/1998
Issue Date	
Publication Date	
Client Ref No	M US96001

## Title

THERMAL HEAD

## Remarks

CIP OF SERIAL NO. 08/697,153 FILED AUGUST 20, 1996 (9281-2254) 11-16-98-FILE SENT TO KI FOR CERT. OF CORRECTION 11/19/98: IDS MEMO SENT WITHOUT FILE CLOSED PER CLIENT INSTRUCTION-6/20/08; MEMO SIGNED BY B. PENDERGAST. MEMO IN 2008 BOOK.

## Actions

## Actions

Bump Action	Base Date	Action Due Date	Indicator	Completed Date	Postcard/Response Sent Date	Notes
Letter	9/22/1998	10/22/1998	Due Date	10/2/1998		US-FORM LETTER / SEND LETTER
File RCT	8/24/1998	10/24/1998	Reminder	9/16/1998	8/24/1998	FILING RECEIPT
DO NOT USE Notice Of Missing Parts	9/9/1998	11/9/1998	Due Date	10/28/1998	11/2/1998	US-APPLICATION FILED / FILING RECEIPT
						US-MISSING PARTS NOTICE / MISSING PARTS
DO NOT USE Notice Miss Parts 1 Mon Ext	9/9/1998	12/9/1998	Due Date	10/28/1998	11/2/1998	SIGNED DECLARATION AND SURCHARGE
						US-MISSING PARTS NOTICE / MISSING PARTS & 1 EXT.
DO NOT USE Notice of missing parts - 2 mo. reminder	9/9/1998	1/9/1999	Due Date	10/28/1998	11/2/1998	SIGNED DECLARATION AND SURCHARGE
						US-MISSING PARTS NOTICE / MISSING PARTS & 2 EXT.
DO NOT USE Notice of missing parts - 3 mo. reminder	9/9/1998	2/9/1999	Due Date	10/28/1998	11/2/1998	SIGNED DECLARATION AND SURCHARGE
						US-MISSING PARTS NOTICE / MISSING PARTS & 3 EXT.
DO NOT USE Notice of missing parts - 2 mo. reminder	9/9/1998	3/9/1999	Final	10/28/1998	11/2/1998	SIGNED DECLARATION AND SURCHARGE
						US-MISSING PARTS NOTICE / MISS. PARTS & 4 EXT.-FINAL
Follow Up	9/22/1998	4/2/1999	Due Date	10/6/1998		SIGNED DECLARATION AND SURCHARGE
						US-FORM LETTER / US-FORM LETTER Follow Up Date
Letter	3/9/1999	4/9/1999	Due Date	3/11/1999		FILING RECEIPT
						US-FORM LETTER / SEND LETTER
Action Due US-For Filing Letter	8/24/1998	4/24/1999	IDC - CPI Gen.	8/24/1998		TRANSMISSION OF PATENT ASSIGNMENT
Follow Up	9/9/1998	4/28/1999	Due Date	10/28/1998	11/2/1998	FFL
						US-MISSING PARTS NOTICE / US-MISSING PART Follow Up Date
Assignment Due	10/28/1998	4/28/1999	Reminder	3/8/1999		SIGNED DECLARATION AND SURCHARGE
						US-ASSIGNMENT FILED / RECORDED ASSIGNMENT
IN-Follow-up?	3/11/1999	5/11/1999	Reminder	3/29/1999		SIGNED DECLARATION AND SURCHARGE
						US-REMINDER / ACKNOWLEDGMENT
Issue Fee Due 1 Month	6/3/1999	7/3/1999	Reminder	9/3/1999		TRANSMISSION OF PATENT ASSIGNMENT
						US-ALLOWANCE / ISSUE FEE 1 MON
Issue Fee Due 2 Months	6/3/1999	8/3/1999	Reminder	9/3/1999		\$1210 and "FORMAL DRAWINGS"
						US-ALLOWANCE / ISSUE FEE 2 MON
DO NOT USE Foreign Filing Completed By US-Foreign Convention - Utility	8/24/1998	8/24/1999	IDC - CPI Gen.	8/24/1998		\$1210 and "FORMAL DRAWINGS"
Issue Fee Due	6/3/1999	9/3/1999	Final	9/3/1999		FRN CONV
						US-ALLOWANCE / ISSUE FEE FINAL
DO NOT USE Continuation Application	6/3/1999	9/3/1999	Reminder	11/16/1999		\$1210 and "FORMAL DRAWINGS"
DO NOT USE Continuation Application	6/3/1999	10/3/1999	Reminder	11/16/1999		US-NOT. ALLOW. CHECKLIST / FILE CONT./SIGN CHECKLIST
DO NOT USE Continuation Application	6/3/1999	11/3/1999	Reminder	11/16/1999		US-NOT. ALLOW. CHECKLIST / FILE CONT./SIGN CHECKLIST
DO NOT USE Continuation Application	6/3/1999	12/3/1999	Due Date	11/16/1999		US-NOT. ALLOW. CHECKLIST / FILE CONT./SIGN CHECKLIST
						US-ALLOWANCE / FEE PAID/FILE CONTINUATION
DO NOT USE Continuation Application	6/3/1999	12/3/1999	Reminder	11/16/1999		\$1210 and "FORMAL DRAWINGS"
Action Due	11/9/1999	12/9/1999	Due Date	1/10/2000		US-NOT. ALLOW. CHECKLIST / FILE CONT./SIGN CHECKLIST
						US-ABANDONMENT NOTICE / PETITION TO REVIVE

Action Due	11/9/1999	1/9/2000	Final	1/10/2000	US-ABANDONMENT NOTICE / PETITION TO REVIVE
Office Action Received?	8/24/1998	2/24/2000	Reminder	6/3/1999	US-FILING DATE / FIRST PTO ACTION
Follow Up	11/9/1999	3/10/2000	Due Date		US-ABANDONMENT NOTICE / FOLLOW UP ON RESPONSE
Follow Up	11/9/1999	4/10/2000	Reminder		US-ABANDONMENT NOTICE / RESPONSE FOLLOW UP
Follow Up	11/9/1999	6/10/2000	Reminder		US-ABANDONMENT NOTICE / FOLLOW UP ON RESPONSE
Follow Up	11/9/1999	7/10/2000	Reminder		US-ABANDONMENT NOTICE / FOLLOW UP ON RESPONSE
Follow Up	11/9/1999	8/10/2000	Reminder		US-ABANDONMENT NOTICE / FOLLOW UP ON RESPONSE
Follow Up	11/9/1999	9/10/2000	Reminder		US-ABANDONMENT NOTICE / FOLLOW UP ON RESPONSE
Follow Up	11/9/1999	10/10/2000	Reminder		US-ABANDONMENT NOTICE / FOLLOW UP ON RESPONSE
US-File Foreign Application(s) - Final		8/24/2003			
Follow Up		9/15/2003	Reminder		status?
Follow Up		1/16/2008	Reminder		printed 3/12/2004 - status?
US-Information Disclosure Statement Due	8/24/1998	6/24/2008	IDC - CPI Gen.		IDS

Inventors

Inventor Name      Assignment Date

KATO, MASAKAZU

SHIRAKAWA, TAKASHI

### File Tracking

#### File Tracking

File Given To	Date Given	Retrieval Location
MAL	11/18/1999	

Telecommute Office 3 8/18/2008 5:51:39 PM

# **Renewed Petition to Revive '307 Application**

## **Exhibit 15**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Petitioner(s): Alps Electric Co., Ltd.

Serial No.: 09/139,307

For: Thermal Head

Filed: August 24, 1998

Examiner: Tran

Art Unit: 2861

Confirmation No.:

Customer No.:

Attorney Docket No. 9860-336549US

**Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**DECLARATION OF TAKAO FUKASU IN SUPPORT OF THE  
PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)**

1. I am Senior Manager in the Intellectual Property Department at Alps Electric Co., Ltd. ("Petitioner"). In this capacity, I am familiar with the prosecution of Petitioner's U.S. patent applications, Petitioner's IP business practices, Petitioner's docketing procedures, how Petitioner interacts with and directs outside counsel in the United States, and, based on my personal knowledge, experience and position at Alps Electric Co., Ltd., can speak on behalf of Petitioner in this matter.
2. The focus of this Declaration is on the prosecution of U.S. Patent Application No. 09/139,307 ("the '307 Application"). Petitioner was the only entity communicating with U.S. counsel regarding the prosecution of the '307 Application.

3. The facts set forth in this Declaration are those that I believe to be relevant to the United States Patent and Trademark Office ("the PTO") in deciding whether to grant the Petition to Revive the '307 Application under 37 C.F.R. § 1.137(b) (unintentional abandonment).
4. As assignee of 100% interest in the '307 Application, Petitioner has the authority under 37 C.F.R. § 3.73 to petition to revive the '307 Application.
5. On December 24, 2008, Petitioner sent a copy of five file histories of five unintentionally abandoned U.S. patent applications, including its file history relating to the prosecution of the '307 Application, to Oblon, Spivak, McClelland, Maier & Neustadt ("Oblon Spivak"). Oblon Spivak confirmed receipt on December 30, 2008. This '307 file history included copies of all of the correspondence with U.S. counsel in Petitioner's possession relating to the '307 Application. Below is a list of the correspondence Petitioner provided to Oblon Spivak:

Date	Description of Document
7/9/1998	Facsimile from William Prendergast of Brinks Hofer Gibson & Lione ("Brinks Hofer") to T. Fukasu of Alps Electric Co., Ltd. ("Alps") regarding filing of continuation application.
8/6/1998	Facsimile from T. Fukasu of Alps to Allan Sternstein of Brinks Hofer enclosing instructions on filing continuing application with attached Preliminary Amendment.
8/28/1998	Letter from William Prendergast of Brinks Hofer to T. Fukasu of Alps enclosing materials filed with PTO in connection with the continuation-in-part Application No. 09/139,307.
10/2/1998	Letter from William Prendergast of Brinks Hofer to Yukimitu Manabe of Alps enclosing Notice to File Missing Parts and discussing requirements for Declaration and Assignment.
10/21/1998	Letter from Y. Manabe of Alps to Allan Sternstein enclosing executed Declaration and Power of Attorney.
10/28/1998	Letter from William Prendergast of Brinks Hofer to Y. Manabe of Alps enclosing copies of documents filed with PTO and transmittal documents.
3/17/1999	Letter from William Prendergast of Brinks Hofer to Y. Manabe of Alps enclosing original Assignment and copy of assignment

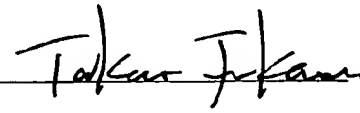
	digest assigning invention to Alps.
3/29/1999	Facsimile from Y. Manabe of Alps to William Prendergast of Alps acknowledging receipt of original Assignment.
6/14/1999	Letter from William Prendergast of Brinks Hofer to Y. Manabe of Alps enclosing Notice of Allowance and instructions re payment of issue fee and filing of formal drawings.
12/28/2006	Letter from T. Fukasu of Alps to Gustavo Siller, Jr. of Brinks Hofer inquiring about the status of four Alps applications, including the '307 Application.
1/11/2007	Facsimile from William Prendergast of Brinks Hofer to T. Fukasu of Alps responding to December 28 inquiry.
7/14/2007	e-mail from William Prendergast of Brinks Hofer to A. Takeda of Alps re inquiry re status of Alps applications
3/2/2008	e-mail from A. Takeda of Alps to William Prendergast of Brinks Hofer inquiring about status of Alps applications.
3/3/2008	e-mail from William Prendergast of Brinks Hofer to A. Takeda of Alps re status of Alps applications.
6/19/2008	e-mail from A. Takeda of Alps to William Prendergast of Brinks Hofer inquiring about status of Alps applications.

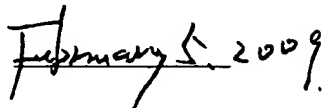
6. Petitioner at no time intended to delay paying the issue fee or filing corrected drawings in response to the June 3, 1999 Notice of Allowance and Issue Fee Due, during the entire period from the due date of the reply to the Notice of Allowance and Issue Fee Due to the present date.
7. Petitioner believed the issue fee was timely paid and the corrected drawings were timely filed with the PTO.
8. Petitioner believed that the prosecution of the '307 Application was delayed several years due to inaction by the PTO.
9. Until September 10, 2008, Petitioner was unaware of the abandoned status of the '307 Application and of the abandoned status of several other similarly situated applications.
10. Petitioner never requested Brinks, Hofer, Gilson & Lione ("Brinks Hofer") or Mr. Prendergast, or any other attorney or Patent Agent, to delay any filing necessary to

the prosecution and Issuance of the '307 Application, or to abandon the '307 Application.

11. Upon learning of the abandonment of the '307 Application, and the abandonment of several additional U.S. patent applications Petitioner then believed were pending, on September 10, 2008, Petitioner promptly investigated the matter internally and with Brinks Hofer attorneys, including reviewing the '307 Application file history and participating in discussions regarding the circumstances that led to the abandonment of the '307 Application and the several other applications. Thereafter, Petitioner chose to retain new patent counsel to take appropriate action to revive the abandoned applications, including identifying new law firms with experience in such matters and having native Japanese speaking attorney(s), interviewing potential new patent counsel, hiring new patent counsel, and working with new counsel to enable them to file petitions to revive the applications.

I declare under the penalty of perjury in the United States that the foregoing is true and correct, to the best of my knowledge.

Signature   
Takao FUKASU  
Senior Manager  
Intellectual Property Department  
ALPS ELECTRIC CO., LTD.

Date 



# **Renewed Petition to Revive '307 Application**

## **Exhibit 16**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Petitioner(s): Alps Electric Co., Ltd.

Serial No.: 09/139,307

For: THERMAL HEAD

Filed: August 24, 1998

Examiner: Tran

Art Unit:

Confirmation No.:

Customer No.:

Attorney Docket No.

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REMARKS AND EVIDENCE SUPPORTING  
PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)**

**DECLARATION OF GUSTAVO SILLER, JR.**

- I. My name is Gustavo Siller, Jr. and I am a shareholder at Brinks, Hofer, Gilson & Lione ("Brinks Hofer"), specializing in the practice of patent prosecution. In this capacity, I am familiar with the prosecution of Alps Electric Co., Ltd.'s ("Alps") U.S. Patent Application No. 09/139,307 ("the '307 Application"), and can speak on behalf of Brinks Hofer in this matter. The facts set forth in this Declaration are those that I believe may be relevant to the United States Patent and Trademark Office ("the PTO") in considering the Renewed Petition to Revive the '307 Application under 37 C.F.R. § 1.137(b).

2. Brinks Hofer filed the '307 Application on August 24, 1998. The '307 Application was a continuation of U.S. Patent Application No. 08/697,153 ("the '153 Application"). The '153 Application was one of several hundred applications owned by Alps that were transferred to Brinks Hofer in or around 1998. The '307 Application was assigned to Alps and Alps was responsible for the prosecution of the '307 Application. The '307 Application was filed by Brinks Hofer. It is my understanding that all due dates for responding to PTO actions in the '307 Application would have been entered into the Brinks Hofer docketing system, as discussed below.
3. My knowledge of the facts of this matter is based on my participation in Brinks Hofer's internal review of the prosecution of the '307 Application, my personal familiarity with the procedures for prosecution of Alps's cases at Brinks Hofer, and my personal familiarity with the Brinks Hofer docketing system and procedures. The matters described in this Declaration primarily relate to William F. Prendergast, the attorney responsible for prosecuting the '307 Application at Brinks Hofer during the 1998 to 2008 time period at issue. Mr. Prendergast was first employed by Brinks Hofer as an associate in the Fall of 1990, and was elected a shareholder effective January 1998. Mr. Prendergast was responsible for prosecuting the '307 Application from the date of filing in August 1998. On August 6, 2008, a Brinks Hofer shareholder informed General Counsel for Brinks Hofer that Mr. Prendergast appeared to have committed suspicious acts in connection with an application matter that Mr. Prendergast was handling for one of Brinks Hofer's clients. Immediately thereafter, Brinks Hofer launched an internal review and investigation of all of the

application matters that Mr. Prendergast was handling, including the prosecution of the '307 Application.

**I. Investigation into the Prosecution of the '307 Application at Brinks Hofer**

4. As part of the 2008 review of Mr. Prendergast's cases, I was responsible for reviewing the '307 Application. More generally, from 1998 to the present, I have been and remain the Brinks Hofer shareholder ultimately responsible for all of Alps's cases at Brinks Hofer. In addition to myself, another Brinks Hofer shareholder, Vincent Gnoffo, who specializes in patent prosecution matters, reviewed the '307 Application file.
5. The initial review of the '307 Application at Brinks Hofer began during the week of August 6, 2008 and continued through October 2008. During that time, I searched Mr. Prendergast's office for information relating to the prosecution of the '307 Application. The Brinks Hofer '307 Application file was found in Mr. Prendergast's office. In my search of Mr. Prendergast's office, I found miscellaneous documents relating to the '307 Application. These loose documents were separate from the '307 Application file found in his office. I also accessed Mr. Prendergast's Brinks Hofer e-mail account and reviewed his e-mail correspondence. I was unable to locate any e-mails on Mr. Prendergast's computer relating to the '307 Application. I reviewed the '307 Application file along with the loose documentation found in Mr. Prendergast's office. I also reviewed a printout of the electronic docket report for the '307 Application from the docketing department, and Mr. Prendergast's time records for the '307 Application from the accounting department.
6. The reviews of the Brinks Hofer '307 Application materials revealed that: (a) a

Notice of Allowability was mailed by the PTO on June 3, 1999 which also stated that several problems with the application's drawings had to be corrected before a patent would issue; (b) a Notice of Allowance and Issue Fee Due was also mailed by the PTO on June 3, 1999; (c) Mr. Prendergast mailed a copy of the Notice of Allowance to Alps along with a letter informing Alps the issue fee was due September 3, 1999 and stating "Unless I hear otherwise from you, I will pay the issue fee and file new formal drawings about one month before the due date"; (d) dates for paying the issue fee and submitting corrected drawings were docketed by the Brinks Hofer docketing department; (e) there is no indication in the '307 Application materials that Alps instructed Mr. Prendergast not to file the issue fee and file formal drawings; (f) it was Brinks Hofer's standard practice for Alps applications to file the issue fee before the due date unless Alps instructed to the contrary; (g) Mr. Prendergast apparently informed the Brinks Hofer docketing department that he had submitted corrected drawings and paid the issue fee because the entries are listed as "Completed" in both the electronic docket and the backup docket book, although no corrected drawings or issue fee appear to ever have been filed; (h) a Notice of Abandonment was mailed by the PTO on November 9, 1999 citing failure to pay the required issue fee; (i) a response to the Notice of Abandonment was docketed by Brinks Hofer; (j) Mr. Prendergast apparently informed the docketing department that he had filed a response because several entries are listed as "Completed" although no response appears to ever have been filed; (k) Mr. Prendergast never informed Alps of the Notice of Abandonment; (l) Mr. Prendergast did not communicate with Alps between June 14, 1999 and January 11, 2007 regarding the '307 Application; and (m) on June

20, 2008, Mr. Prendergast informed the Brinks Hofer docketing department that Alps authorized him to abandon the '307 Application and close the file, even though Alps never gave any such authorization.

7. On September 16, 2008, I requested a Power to Inspect the PTO's '307 Application file history. I reviewed the PTO's '307 Application file history and confirmed that nothing was filed in response to the Notice of Allowability, Notice of Allowance and Issue Fee Due, or Notice of Abandonment.
8. Brinks Hofer sought Mr. Prendergast's assistance and cooperation with the review of and explanations concerning the prosecution of the '307 Application. Brinks Hofer did not receive the requested assistance or any explanations from Mr. Prendergast. Mr. Prendergast was suspended on August 8, 2008, and Brinks Hofer terminated his employment on August 14, 2008. Brinks Hofer submitted a report to the Illinois Attorney Registration and Disciplinary Commission summarizing Mr. Prendergast's apparent misconduct in connection with his mishandling approximately 24 patent applications. In 2009, Mr. Prendergast moved to have his name stricken from the Roll of Attorneys at the Illinois State Bar.

## **II. The Brinks Hofer Docketing System**

9. From the time the '307 Application arrived at Brinks Hofer in 1998 to the present, Brinks Hofer has maintained an electronic docket system for docketing all due dates for any case prosecuted at the firm. During my 21 years at Brinks Hofer, several versions of this software have been in place and used to successfully prosecute thousands of patent applications.
10. The docketing department maintained the electronic docketing system and also

maintained a manual back-up log. In 2002, Brinks Hofer changed software for its electronic docketing system. Electronic reports from the prior software system are no longer available, but a docket report for the '307 Application was generated using the newer software. Ex. 14. Some data reflected on the docket report has changed due to the conversion of software systems. For instance, the term "Do Not Use" appears before certain entries because various standard entries, to be selected from a drop down list, were changed in the new software program.

11. On the '307 Application docket report, the listed supervising attorney is myself, and the responsible attorney is Vincent J. Gnoffo. *Id.* As discussed above, Mr. Gnoffo also reviewed the file during the investigation of the files for the '307 Application and was listed as the responsible attorney for the '307 Application. My name appears as the supervising attorney because I am ultimately listed as the supervising attorney for all of Alps's cases at Brinks Hofer. However, I had no substantial involvement in the day-to-day to prosecution of the '307 Application. Instead, William Prendergast was the responsible attorney at Brinks Hofer who handled prosecution of the '307 Application.
12. I have consulted with Brinks Hofer's docketing department concerning reminders that would have been provided to Mr. Prendergast during the prosecution of the '307 Application. Because Mr. Prendergast was the responsible attorney for the '307 Application, the docketing department would have provided Mr. Prendergast with two types of reminders with respect to the '307 Application due dates. The first was a monthly printed report showing reminders for all of Mr. Prendergast's cases for three months after the date of the report. The monthly reports for the '307

Application were not found in Mr. Prendergast's office or files, but Mr. Prendergast, as the responsible attorney, would have received these monthly reports. The second type of reminder was a series of voice mails concerning due dates. Every Friday a voice mail reminder was sent to the responsible attorney with a list of all due dates for the next nine days, and a voice mail reminder was also sent to the responsible attorney for all due dates on the date of the reminder. The daily voice mail reminders requested that the responsible attorney inform the docketing department of the action to be taken on the matter. These reminders would have continued until the docketing department was told in writing or orally that the action at issue had been completed.

13. Once a responsible attorney completed a due date entry on the docket sheet, the attorney would submit a pink card to notify the docketing department to clear items from the prosecution docket as responses were filed. Under the normal practice of Brinks Hofer, a document to be filed at the PTO was submitted to docketing with a filled-in pink card that indicated the nature of the document. The docketing department would then review the submission and clear the docket. An exception to this procedure was for filings made after normal business hours. In such instances, an attorney was permitted to mail the document to the PTO and leave only the pink card with the Brinks Hofer docketing department. Mr. Prendergast was known to work after hours. In some instances pink cards were submitted to the docketing department by Mr. Prendergast bearing the words "Didn't see" in the upper right-hand corner. This indicates that the Brinks Hofer docketing clerk "did not see" the accompanying document. Thus, by submitting pink cards to the Brinks Hofer docketing department after normal business hours, Mr. Prendergast was able to clear a docketed item



without having a docketing clerk examine any materials that Mr. Prendergast purportedly submitted to the PTO. In such instances, as far as the firm knew, the open item in the docketing system was satisfied, and the usual alarms that the firm had in place to warn of impending but unsatisfied deadlines were effectively deactivated.

14. During my review of the '307 Application materials I did not find pink cards indicating that Mr. Prendergast had filed the corrected drawings and issue fee. Mr. Prendergast did, however, put copies of what purported to be the submission of formal drawings and payment of the issue fee in the Brinks Hofer '307 Application file. I believe it is possible that Mr. Prendergast also submitted a false pink card or other material to the Brinks Hofer docketing department or orally communicated with the docketing department personnel to convince them that the corrected drawings and issue fee had been filed with the PTO in the '307 Application. If this occurred (and my review of Mr. Prendergast's files indicates that he did submit false pink cards in several other Alps applications including nos. 08/960,481 and 08/740,521), then as far as the firm knew, the open item in the docketing system was satisfied, and the usual alarms that the firm had in place to warn of impending but unsatisfied deadlines were effectively deactivated.
15. I have been an attorney at Brinks Hofer since 1988 and have successfully relied on the Brinks Hofer docketing system and department in my patent prosecution practice for 21 years. I believe that throughout the time period Mr. Prendergast was employed by Brinks Hofer, the firm had an effective docketing system in place – one designed to remind attorneys and ultimately warn the Brinks Hofer administration of filings

that needed to be made by a certain date. The docketing system was not designed to catch an attorney who intentionally misled Brinks Hofer or provided false information to the Brinks Hofer docketing department. In a law firm such as Brinks Hofer where shareholders trust one another, such additional safeguards were not considered necessary. With the exception of Mr. Prendergast, I have never known anyone at Brinks Hofer who has manipulated or intentionally circumvented the docketing system. Up until the investigation associated with Mr. Prendergast in 2008, I always had complete confidence in the electronic docketing system and the procedures set up at Brinks Hofer for following-up on all due dates.

### **III. The June 3, 1999 Notice of Allowability**

16. On June 3, 1999, the PTO mailed a Notice of Allowance and a Notice Allowability to Brinks Hofer. Ex. 3. The '307 Application file indicates these notices were sent to Alps on June 14, 1999. Ex. 1. The forwarding letter to Alps noted that the issue fee was due September 3, 1999 and stated "Unless I hear otherwise from you, I will pay the issue fee and file new formal drawings about one month before the due date." *Id.*
17. The Brinks Hofer docketing department docketed a July 3, 1999 one month reminder for the Notice of Allowance, and an August 3, 1999 two month reminder for payment of the issue fee and submission of the corrected drawings for the allowed '307 Application. Ex. 14, p. 1. The docketing department also docketed a final due date for paying the issue fee on September 3, 1999. *Id.* Based on the Brinks Hofer docketing department practices at that time, I believe the docketing department sent Mr. Prendergast monthly printouts of this docket sheet with the docketed reminders and due date and voice mail reminders for the due date entry. All of these docket

entries list a completed date of September 3, 1999.

18. The manual backup docket log for September 3, 1999 includes an entry for payment of the issue fee and submission of corrected drawings, with a black line through the docket entry and a handwritten date, "9/3/99." Ex. 2. The line through the docket entry and the handwritten date indicate that the docketing department believed the issue fee and corrected drawings were submitted to the PTO on September 3, 1999, and that the docket entry could be cleared. Based on Mr. Prendergast's actions in other Alps cases, it is possible he informed the docketing department that the '307 Application issue fee was paid and the corrected drawings were submitted to the PTO, which prompted the department to clear the docket entry and enter a completed date of September 3, 1999 in the electronic docketing system.
19. Also, during the investigation into Mr. Prendergast's actions, a copy of what purports to be a cover sheet for the Submission of Formal Drawings and payment of the issue fee dated September 3, 1999 was found in the '307 Application file. Ex. 4. Along with this, the actual check as well as an envelope addressed to "Hon. Commissioner of Patents & Trademarks, Washington DC 20231" was found with the file. Ex. 5. Consistent with these documents, the Brinks Hofer docketing system indicates that the docketing department believed that a response had been filed on September 3, 1999. Exs. 2, 14. Based on Mr. Prendergast's actions in this case and other cases, it appears likely that he either provided copies of these papers to the docketing department or took other steps to convince the docketing department that the Issue Fee and related papers had been submitted to the PTO on September 3, 1999. In fact, the record indicates that Mr. Prendergast never submitted formal drawings or paid the

issue fee for the allowed '307 Application.

20. The docketing department docketed reminders for a "Notice of Allowance Checklist" and a reminder for filing a continuation for the '307 Application from September 3, 1999 through December 3, 1999. Ex. 14. The Notice of Allowance Checklist was an internal Brinks Hofer document where the attorney would check and verify that certain activities had been completed in the application. Such activities included, among others, verifying that any claim to priority had been properly made, verifying that an assignment had been properly signed and recorded, and verifying that prior art had been properly cited to the PTO. The reminders from September 3, 1999 through December 3, 1999 were docketed because Mr. Prendergast had not returned a signed copy of the Notice of Allowance Checklist to the docketing department and had not confirmed that a continuation application would or would not be filed. Based on the Brinks Hofer docketing department practices at that time, I believe the docketing department sent Mr. Prendergast monthly printouts of this docket sheet with the docketed reminders and due date and voice mail reminders for the due date entry. All of these docket entries list a completed date of November 16, 1999 because Mr. Prendergast completed and signed the Notice of Allowance Checklist. Ex. 24.

#### **IV. The November 9, 1999 Notice of Abandonment**

21. A Notice of Abandonment, addressed to Mr. Prendergst, was sent to Brinks Hofer on November 9, 1999. Ex. 6. There is no indication in the '307 Application file that the Notice of Abandonment was ever forwarded to Alps. Yet the Brinks Hofer docketing department docketed entries for responding to the Notice of Abandonment. Ex. 14. My review of the '307 Application docket sheet shows that the Brinks Hofer

docketing department docketed due dates to file a Petition to Revive the '307 Application on December 9, 1999 and January 9, 2000. *Id.* at pp. 1, 2. Based on the Brinks Hofer docketing practices at that time, I believe the docketing department sent Mr. Prendergast monthly printouts of this docket sheet with the docketed due dates and voice mail reminders for the due date entries. These due dates were marked as completed on January 10, 2000. *Id.* It is not clear why the docket sheet reports a "completed" date of January 10, 2000. However, I believe it is likely that Mr. Prendergast gave an instruction to the docketing department that the due dates could be cleared. The docket sheet resumes listing follow-up docket reminder entries for the Notice of Abandonment from March through October 2000. It is likely the docketing department resumed making docket entries for responding to the Notice of Abandonment because it did not receive any pink cards or documentation confirming that a response to the Notice of Abandonment had been filed at the PTO. Based on the Brinks Hofer docketing practices at that time, I believe the docketing department sent Mr. Prendergast monthly printouts of this docket sheet with the docketed reminders for following up on the Notice of Abandonment. No completion date is listed for these entries. It is not clear why no completion date for these entries appears on the docket sheet or why the entries stop in October 2000. It is possible that Mr. Prendergast gave an instruction to the docketing department that the follow-up Notice of Abandonment reminders were no longer necessary since a response to the Notice of Abandonment had allegedly been filed.

22. My review of the files thus indicates that Mr. Prendergast never filed a response to the November 9, 1999 Notice of Abandonment or took any other actions to maintain

pendency of the '307 Application after November 9, 1999, and never forwarded the Notice of Abandonment to Alps.

#### **V. Events from 2006 to 2008**

23. On September 10, 2008, I contacted Alps and informed them of the abandoned status of the '307 Application. During subsequent communications with Alps, Brinks Hofer learned that Alps was not previously aware that the '307 Application had become abandoned.
24. At my request in order to complete my records, on October 8, 2008, Alps sent me an e-mail attaching facsimile and e-mail correspondence from 2006 and 2008 between Mr. Prendergast and Alps regarding the prosecution of the '307 Application. This correspondence was not in the '307 Application file or Mr. Prendergast's e-mail account.
25. On December 28, 2006 Alps sent a facsimile to my attention regarding the status of several applications, including the '307 Application. Ex. 8. Because Mr. Prendergast was the responsible attorney, I believe this facsimile would have been directly routed to him. On January 11, 2007 Mr. Prendergast responded to Alps's December 28, 2006 facsimile stating that the delay was due to the PTO losing the file and that Alps could expect to hear something in the next 2-3 months. Ex. 9. There is no indication in the record, however, that the PTO ever lost the '307 Application file or that Mr. Prendergast had any good faith basis for reporting that Alps could expect communication from the PTO within the next 2-3 months.
26. After further inquiry from Alps on July 11, 2007, Mr. Prendergast, on July 14, 2007, e-mailed Alps stating that the '307 Application matter was being investigated and that

he scheduled a call with a PTO supervisor to attempt to resolve the matter urgently.

Exs. 10, 22. Alps e-mailed Mr. Prendergast on July 17, 2007 stating that it understood the situation and would wait for Mr. Prendergast's further report (Ex. 22), and then again on June 19, 2008 requesting that Mr. Prendergast contact the PTO and accelerate examination of the '307 Application. (Exs. 10, 23). Mr. Prendergast responded on June 19, 2008 stating that he would follow up immediately and that he had been advised recently that a response on this matter was expected in the near future. Ex. 23. There is no record of any further communication between Alps and Mr. Prendergast regarding the '307 Application.

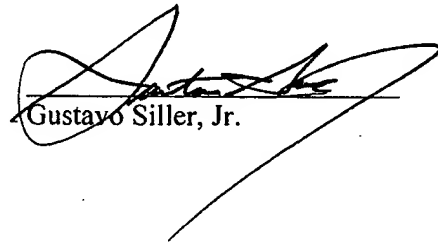
27. On June 20, 2008, Mr. Prendergast submitted a file closure form to the Brinks Hofer docketing department stating that the '307 Application was being abandoned pursuant to Alps's instructions. Ex. 11. My review of the '307 Application materials indicates that Alps did not instruct Mr. Prendergast to abandon the '307 Application.
28. On September 25, 2008, I met with Alps in Tokyo, Japan to discuss the '307 Application. During this meeting, I advised Alps that we had uncovered that the '307 Application had been abandoned without Alps's authorization and that the correspondence we had uncovered indicated that Mr. Prendergast had incorrectly led Alps to believe that the '307 Application was pending.
29. On October 15, 2008, Brinks Hofer delivered its report concerning Mr. Prendergast's conduct to the Illinois Supreme Court's Attorney Registration and Disciplinary Commission and mailed a copy of the report via overnight delivery to the PTO's Office of Enrollment and Discipline.
30. Based on my own review of the '307 Application, my discussion with Alps after

August 2008, the related investigation, and my personal knowledge of the procedures for prosecuting patent applications at Brinks Hofer, I believe that Alps never instructed Brinks Hofer to abandon the '307 Application, that Alps never instructed Brinks Hofer to delay in submitting corrected formal drawings and paying the issue fee, and that Alps never instructed Brinks Hofer to delay in filing a Petition to Revive the '307 Application. In addition, I am aware of no dispute over legal fees between Alps and Brinks Hofer, or any other dispute that could have had any effect on the prosecution of the '307 Application.

I declare under the penalty of perjury in the United States that the foregoing is true and correct, to the best of my knowledge.

Date: 10/2/09

Signature:

  
Gustavo Siller, Jr.



# **Renewed Petition to Revive '307 Application**

## **Exhibit 17**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Petitioner(s): Alps Electric Co., Ltd.

Serial No.: 09/139,307

For: THERMAL HEAD

Filed: August 24, 1998

Examiner: Tran

Art Unit:

Confirmation No.:

Customer No.:

Attorney Docket No. 336549US

**Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

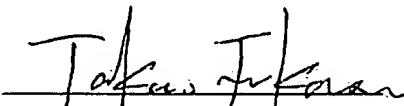
**SUPPLEMENTAL DECLARATION OF TAKAO FUKASU IN SUPPORT OF  
THE RENEWED PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)**

1. I am Senior Manager in the Intellectual Property Department at Alps Electric Co., Ltd. ("Alps" or "Petitioner"), and based on my personal knowledge, experience and position at Alps, I can speak on behalf of Petitioner regarding the prosecution of U.S. Patent Application No. 09/139,307 ("the '307 Application"). My previous Declaration in support of the Petition to Revive the '307 Application was filed on February 10, 2009.
2. Petitioner had the authority to reply to the United States Patent and Trademark Office ("the PTO") to avoid abandonment of the '307 Application at the time the '307 Application went abandoned on November 9, 1999.
3. Petitioner was assignee of, and has had control of, the prosecution of the '307

Application from the filing date of the '307 Application, on August 24, 1998, to the present.

4. Petitioner relied on its U.S. counsel, Brinks Hofer, Gilson & Lione ("Brinks Hofer") for at least (1) docketing all necessary dates for its U.S. applications, (2) advice concerning all aspects of PTO procedure and (3) keeping Petitioner informed of all developments and deadlines in the '307 Application. When no due dates for responding to the PTO were known to be pending, Petitioner did not have an independent mechanism other than its reliance on Brinks Hofer for identifying unusually long periods of time that had passed with no activity in a particular application.
5. There is no written record of what circumstances first prompted Petitioner to ask Brinks Hofer about the status of the '307 Application in August 2006. However, in 2006, the Alps IP department reviewed its U.S. applications whose examination by the PTO seemed to have been very much delayed, and as a result of the review, it was confirmed that in the '307 Application there had been no responses from the PTO for several years.

I declare under the penalty of perjury in the United States that the foregoing is true and correct, to the best of my knowledge.

Signature   
Takao FUKASU  
Senior Manager  
Intellectual Property Department  
ALPS ELECTRIC CO., LTD.

Date October 1, 2009

**Renewed Petition to Revive  
'307 Application**

**Exhibit 18**

Members:

Silicon Valley / San Jose Business Journal - February 4, 2003  
[/sanjose/stories/2003/02/03/daily27.html](http://sanjose/stories/2003/02/03/daily27.html)

SILICON VALLEY / SAN JOSE  
**BusinessJournal**

Tuesday, February 4, 2003

## Skjerven Morrill to close

Silicon Valley / San Jose Business Journal

**Skjerven Morrill LLP** says its partners have voted to dissolve the intellectual property firm after merger talks fell through.

With offices in San Jose and San Francisco, Skjerven Morrill employs 62 attorneys and 152 staff. The law firm's partners decided the firm could not continue because of "the cumulative effect of the continuing downturn in the general and technology economies, as well as the major structural changes in the firm's organization and geographic base and continuing declines in attorney and staff levels, during the past year," according to a statement released by a spokesman.

Skjerven Morrill's planned closing comes just a few days after San Francisco law giant Brobeck Phleger & Harrison LLP, suffering from a steep drop in profits, said it would dissolve its law practice after merger negotiations with an unnamed Philadelphia-based firm broke off. Brobeck continues to wind down and negotiate payments on its debt with its primary bank lender, Citibank.

Skjerven Morrill was in merger talks with Pillsbury Winthrop LLP of San Francisco and Chicago's Sidley Austin Brown & Wood LLP, according to the legal newspaper The Recorder. After both discussions proved fruitless, Skjerven Morrill partners decided to close shop by March 1.

At its peak in the fall of 2002, Skjerven Morrill had 135 attorneys. But as business fell off, the firm closed its offices last April in Austin, Texas, and Newport Beach in Southern California, and at about the same time partner Alan MacPherson left the firm.

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# **Renewed Petition to Revive '307 Application**

## **Exhibit 19**



September 4, 2009

Via facsimile

David Belofsky, Esq.  
Belofsky & Belofsky  
33 N. Dearborn Street, Suite 2330  
Chicago 60602

ATTORNEYS AT LAW

RICHARD L. TREANOR  
(703) 412-6007  
RTREANOR@OBLON.COM

ANDREW K. BEVERINA  
(703) 412-6420  
ABEVERINA@OBLON.COM  
\*BAR OTHER THAN VIRGINIA

Re: Request for Declarations from William F. Prendergast  
Our Ref. No. 336544US

Dear Mr. Belofsky,

This letter is to memorialize our September 3, 2009 conversation.

You informed me that you have advised your client, William Prendergast, not to sign the declaration I sent you relating to a petition to revive an application abandoned by Mr. Prendergast. You further informed me that you have advised him not to sign any version of any declaration relating to any petition to revive applications of Alps Electric Co., Ltd.

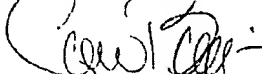
I also understand this to mean that Mr. Prendergast is not willing to discuss any of these applications with us, as I requested in my September 1, 2009 letter to you.

If you believe any of the information above is in error, please contact me immediately at (703) 412-6420 or [abeverina@oblon.com](mailto:abeverina@oblon.com).

Best regards,

Sincerely,

OBLON, SPIVAK, McCLELLAND  
MAIER & NEUSTADT, P.C.



Andrew K. Beverina

# **Renewed Petition to Revive '307 Application**

## **Exhibit 20**



**RECEIVED**

SEP 04 2009

OBLON, SPIVAK

**BELOFSKY & BELOFSKY, P.C.**

ATTORNEYS AT LAW

33 NORTH DEARBORN STREET

SUITE 2330

CHICAGO, ILLINOIS 60602

TELEPHONE (312) 759-3737

FACSIMILE (312) 759-1262

**FACSIMILE COVER SHEET**

**TO:** Andrew Bevarina

**FROM:** Douglas M. Belofsky

**FACSIMILE NUMBER:** 703-413-2220

**DATE:** September 4, 2009

**WE ARE TRANSMITTING** 2 **PAGES (INCLUDING THIS COVER LETTER)**

**MESSAGE:** \_\_\_\_\_  
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This message is intended only for the use of the individual or entity to which it is addressed, and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original message to us at the above address via the U.S. postal service without making a copy. Thank you for your cooperation and assistance.

**BELOFSKY & BELOFSKY, P.C.**

ATTORNEYS AT LAW  
33 NORTH DEARBORN STREET  
SUITE 2330  
CHICAGO, ILLINOIS 60602  
TELEPHONE (312) 759-3737  
FACSIMILE (312) 759-1262

September 4, 2009

**Via Facsimile & First Class Mail**

Andrew K. Beverina  
Oblon Spivak  
1940 Duke Street  
Alexandria, Virginia 22314


Re: Request for Declarations from William F. Prendergast  
Your Reference No. 336544US

Dear Mr. Beverina:

Thank you for your letter of September 4, 2009, the content of which is materially incorrect. In our conversation I only advised you that Mr. Prendergast would be unable to subscribe to the declaration you proposed. I did not share with you any advice that Mr. Prendergast may have received. Nor did I even mention whether Mr. Prendergast has received any legal advice.

We wish you and your client well, and hope you have an enjoyable holiday weekend.

Very truly yours,



David A. Belofsky

DAB:jb

# **Renewed Petition to Revive '307 Application**

## **Exhibit 21**

**OBLON**  
**SPIVAK**

September 8, 2009

Via facsimile

David Belofsky, Esq.  
Belofsky & Belofsky  
33 N. Dearborn Street, Suite 2330  
Chicago 60602

ATTORNEYS AT LAW

RICHARD L. TREANOR  
(703) 412-6007  
RTREANOR@OBLON.COM

ANDREW K. BEVERINA  
(703) 412-6420  
ABEVERINA@OBLON.COM  
\*BAR OTHER THAN VIRGINIA

Re: Request for Declarations from William F. Prendergast  
Our Ref. No. 336544US

Dear Mr. Belofsky,

I am in receipt of your September 4, 2009 facsimile letter. To clarify, it was my understanding that Mr. Prendergast would not sign the declaration we sent or any other version of the declaration. It was also my understanding that Mr. Prendergast declined to speak with us.

Please contact me immediately if you disagree with the above.

Best regards,

Sincerely,

OBLON, SPIVAK, McCLELLAND  
MAIER & NEUSTADT, P.C.



Andrew K. Beverina

# **Renewed Petition to Revive '307 Application**

## **Exhibit 22**



akiko\_8002812  
takeda/jh00/adm0/jp  
2007/07/17 15:59

宛先 "Prendergast, William" <WFP@brinkshofer.com>

cc

bcc

件名 Re: Request For Current Status□

Dear Mr. Prendergast,

I understand. We will wait for your further report on this matter.  
Thank you for your prompt action.

Sincerely,  
Akiko Takeda

"Prendergast, William" <WFP@brinkshofer.com>



"Prendergast, William"  
<WFP@brinkshofer.com>  
2007/07/14 08:47

宛先 <akiko.takeda@jp.alps.com>

cc

件名 Request For Current Status

Re: Application No. 08/738,435 (9281-2881/FC US95004)

Ms. Takeda,

Thank you for your email to Ms. Hall of July 11, 2007 regarding the referenced applications. We are currently investigating the matter with US PTO and will make every effort to advance the prosecution of the referenced applications. I have scheduled a call with supervisor at the PTO for next week to attempt to get this matter resolved on a urgent basis. Please let me know if you have any questions.  
William Prendergast

William Prendergast  
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# **Renewed Petition to Revive '307 Application**

## **Exhibit 23**

## Prendergast, William

---

**From:** Prendergast, William  
**Sent:** Thursday, June 19, 2008 6:21 AM  
**To:** 'akiko.takeda@jp.alps.com'  
**Cc:** Siller, Gus; Brady, Courtney  
**Subject:** Re: Request For Current Status [Very Important]

Ms. Takeda

Thank you for your email. I will follow up immediately. I was advised recently that we should expect a response on this matter in the near future. But, I will confirm this with the PTO and respond shortly.

William Prendergast

----- Original Message -----

**From:** akiko.takeda@jp.alps.com <akiko.takeda@jp.alps.com>  
**To:** Prendergast, William  
**Cc:** Siller, Gus; Brady, Courtney  
**Sent:** Thu Jun 19 02:40:21 2008  
**Subject:** Re: Request For Current Status [Very Important]

Dear Mr. Prendergast,

With respect to the following cases, would you please contact the USPTO to accelerate an examination procedure of these cases ?

We have not received any action from the USPTO for a quite long time.

(Embedded image moved to file: pic00041.jpg)

Thank you in advance.

Sincerely,  
Akiko Takeda

"Prendergast,  
William"  
<WFP@brinkshofer.  
com>

2008/03/03 22:56

<akiko.takeda@jp.alps.com>

宛先

cc

"Siller, Gus"  
<gsiller@brinkshofer.com>  
<junji.kobayashi@jp.alps.com>

件名

Re: Request For Current Status  
[Very Important]



# **Renewed Petition to Revive '307 Application**

## **Exhibit 24**

## NOTICE OF ALLOWANCE CHECKLIST

Review and check all applicable boxes. This form, signed and dated, must be returned with the file at the time of paying the issue fee.

1. PRIORITY CLAIM HAS BEEN MADE AND THE CERTIFIED COPY OF THE PRIORITY APPLICATION HAS BEEN PROVIDED TO THE PTO (see 37 C.F.R. §1.55)

☒

Completed.

☐

Not applicable.

☐

Will be completed by \_\_\_\_\_

2. DRAWINGS (see 37 C.F.R. §1.85)

☒Corrected drawings filed on 9/3/9☐

Correction of drawings not required.

☐

No drawings in the application.

3. ASSIGNMENT

☒

Filed

☐

Will be filed \_\_\_\_\_

☐

Not applicable.

4. CONTINUATION, DIVISIONAL, CIP (see 35 U.S.C. §§120, 121, 154, 365(c))

☒

If this application is a continuation or a divisional, proper cross reference to earlier case(s) has been made in first sentence of specification.

☐

If this application is a CIP, the desirability of claiming the benefit of an earlier filing date under 35 U.S.C. §120 has been considered. If desirable, proper cross reference to earlier case(s) has been made in first sentence of specification. If not desirable, cross reference to the earlier case(s) has been deleted.

☒ Case has been reviewed to determine whether a divisional, continuation, or C-I-P should be filed, and client has been advised.

☒ No divisional, continuation or CIP applications will be filed.

☐ Yes, the following applications will be filed (please specify number): \_\_\_ divisional(s), \_\_\_ continuation(s), or \_\_\_ CIP(s).

5. SMALL ENTITY STATUS (37 C.F.R. §1.28(b))

☐ Reviewed and found correct.

☐ PTO notified small entity status no longer proper.

6. DUTY OF CANDOR

☒ All material information has been disclosed to PTO, including prior art encountered in prosecution of corresponding or related foreign cases (see 37 C.F.R. §§1.56 and 1.97). [NOTE: If all material information has NOT been disclosed to PTO and cannot now be provided to the PTO so that it will be considered by the Examiner, this application must be abandoned and a continuation application filed.]

7. INVENTORSHIP

☒ Determined that inventorship is correct for invention covered by allowed claims.

☐ Determined that inventorship is incorrect for invention covered by allowed claims, and correction of inventorship is being sought (see 37 C.F.R. §1.48).

Date

11/16/94

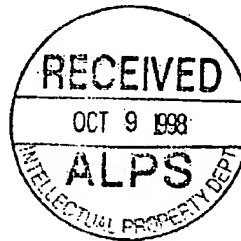
\_\_\_\_\_  
ATTORNEY'S SIGNATURE

[10/31/95]

# **Renewed Petition to Revive '307 Application**

## **Exhibit 25**

William F. Prendergast  
wfp@brinkshofer.com  
312-321-4242



BRINKS  
HOFFER  
GILSON  
& LIONE

October 2, 1998



A PROFESSIONAL CORPORATION  
INTELLECTUAL PROPERTY ATTORNEYS



NBC Tower - Suite 3600  
455 N. Cityfront Plaza Drive  
Chicago, Illinois 60611-5599  
FACSIMILE 312-321-4299  
TELEPHONE 312-321-4200

VIA DHL

Mr. Yukimitu Manabe  
Manager  
Patent Applications Center  
Alps Electric Co., Ltd.  
1767 Nippa-cho, Kohoku-Ku  
Yokohama-shi, 223-8502 JAPAN

Re: U.S. Patent Application Serial No. 09/139,307  
"Thermal Head"  
Your File No. M US96001  
Our File No. 9281/3130

Dear Mr. Manabe:

Enclosed is a copy of the Notice to File Missing Parts of Application. Since this patent application was filed without an Assignment and combined Declaration and Power of Attorney, enclosed are an Assignment and a combined Declaration and Power of Attorney. Please have the inventors sign the following enclosed documents.

- Declaration and Power of Attorney for Patent Application (Japanese Language Declaration) - should be signed and dated by all inventors. Please insert/confirm complete addresses where indicated.
- Assignment - should be signed and dated by all inventors before two witnesses.

The inventors' signatures on the Declaration certify that they have reviewed and understand the specification, including the claims. Failure to read and understand that specification, jeopardizes the application as well as any patent or patents which issue from the application.

The Declaration and Assignment should then be returned to us so that we can file them in the U.S. Patent and Trademark Office.

Mr. Yukimitu Manabe

October 2, 1998.

Page 2

Please keep in mind that a patent applicant is obliged by law to bring to the attention of the U.S. Patent and Trademark Office all prior art and prior acts (articles, publications such as books, devices used, sold or offered for sale) that the applicant is aware of and which are relevant to the applicant's invention. If you or the inventors are aware of any such prior art or acts, now or in the future, please let us know as soon as possible. If you are in doubt as to whether something is prior art or relevant to the above-identified invention, please let us know and we can help you decide.

If you have any questions on this matter, please contact me immediately.

Very truly yours,



William F. Prendergast

WFP/lip  
Enclosures